

## 修正與Festo魔咒

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### 壹、前言

按專利權之權利範圍之認定，向來即為專利訴訟案件中之主要爭議，尤其在專利侵權之認定上，其首要之務在於申請專利範圍之解讀(claim construction)，而申請專利範圍解讀底定後，則侵權與否或專利之有效性(validity)爭議，基本上已可看出端倪，因此，專利權之權利範圍在專利訴訟中扮演著極其關鍵的角色。

實則，申請專利範圍之解讀，尤其是個別限制條件之意涵(meaning)，會因為說明書之撰寫與申請專利過程之作爲而引起變化，因此，以實務而言，進行訴訟前，必須先向美國專利局取得該專利之全卷檔案(file wrapper)。

另一方面，於2000年之Festo案引起震撼後，隨之而來一系列對均等論(doctrine of equivalents)之探討，亦再度喚起吾人對申請專利範圍撰寫之重視，如何撰寫合宜的申請專利範圍以避免陷入Festo要因之泥淖，成爲專利工作者關切的課題。

本文擬由說明書與申請專利範圍之關係，以及均等論與禁反言(estoppel)之演進，探討對申請專利範圍之個別限制條件所引起之權利範圍變化，並配合美國聯邦巡迴法院之判決爲實例說明。

### 貳、發明說明與申請專利範圍

按美國專利法第112條開宗明義規定，說明書(specification)必須包括發明之書面描述(written description of the invention)，習慣稱爲發明說明，或詳細說明<sup>1</sup>，而其後進一步規定，說明書必須包括一或

以上之申請專利範圍項，以特定指出及清楚地請求申請人認爲是其發明之主題標的<sup>2</sup>，是以，美國專利法將原始(original)提交之申請專利範圍隸屬於「專利說明書」<sup>3</sup>，此與我國之現行專利法係爲相同者<sup>4</sup>，唯稍異於規則歐洲專利公約(European Patent Convention, EPC)之相關規定<sup>5</sup>。

固然美國專利法對專利說明書尚有其他規定，唯基本上，其與申請專利範圍間有密不可分之關係，亦即：「說明書教示(teach)，申請專利範圍請求(claim)」<sup>6</sup>；易言之，說明書其係用以揭示(disclosure)，並使熟習該項技藝人士可爲相同之製造與使用，而申請專利範圍則爲界定發明之專利保護(the scope of patent protection)範圍<sup>7</sup>。

#### (一)發明說明要件

「發明說明」一詞首先出現於1793年之美國專利法，而在當時，申請專利時並不必提交申請專利範圍，而是足夠使其發明區別於先前已知或使用之事物爲已足<sup>8</sup>，此階段之發明說明之功能與要件之滿足，在於致能性(enablement，亦稱可實施性)<sup>9</sup>。

his invention.

<sup>2</sup> [¶ 2] The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

<sup>3</sup> See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 938, 15 USPQ2d 1321, 1326 (Fed. Cir. 1990) ("The original claims as filed are part of the patent specification.").

<sup>4</sup> 見我國專利法第25條及第26條。

<sup>5</sup> Art. 78 EPC: (1) A European patent application shall contain: (a) a request for the grant of a European patent; (b) a description of the invention; (c) one or more claims; (d) Any drawings referred to in the description or the claims; (e) an abstract.

<sup>6</sup> SRI Int'l v. Matsushita Elec. Corp., 775 F.2d 1107, 1121, 227 USPQ 577, 585, n.14 (Fed. Cir. 1985) ("Specifications teach. Claims claim.").

<sup>7</sup> Both the Supreme Court and this court have adhered to the fundamental principle that claims define the scope of patent protection. See, e.g., Aro Mfg. v. Convertible Top Replacement Co., 365 U.S. 336, 339 (1961) ("[T]he claims made in the patent are the sole measure of the grant . . ."); Cont'l Paper Bag Co. v. E. Paper Bag Co., 210 U.S. 405, 419 (1908) ("[T]he claims measure the invention."); Atl. Thermoplastics Co. v. Faytex Corp., 974 F.2d 1299, 1300, 24 USPQ2d 1138, 1139-40 (Fed. Cir. 1992) ("The claims alone define the patent right."); SRI Int'l v. Matsushita Elec. Corp., 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) ("It is the claims that measure the invention.").

<sup>8</sup> See Enzo Biochem v. Gen-Probe, Inc., 296 F.3d 1316, 1324, 63 USPQ2d 1609, 1613 (Fed. Cir. 2002) The words "written description" first appeared in the Patent Act of 1793. At that time, of course, patents did not require claims but only a written description sufficient "to distinguish [the invention] from all

<sup>1</sup> § 112. Specification

[¶ 1] The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out

而於 1822 年之 *Evan V. Eaton* 案之判決中，美國最高法院將發明說明解讀為要求申請人除了可致能其發明外，尚須能提供告知之功能<sup>9</sup>，事實上，發明說明應具致能性之揭示，直到 2001 年之美國最高法院於 *J.E.M. Ag. Supply* 案仍維持這種見解，並認為是除了新穎性 (novelty)，實用性 (utility) 及非顯而易知性 (non-obviousness) 外之另一要件<sup>11</sup>。

目前美國聯邦巡迴上訴法院之前身，亦即美國關務與專利上訴法院 (United States Court of Customs and Patents Appeal)，簡稱 (CCPA) 仍一直維持此觀點，唯於 1962 年之 *In re Gay* 案中，曾將美國專利法 112(1) 解讀為要求兩要件，即致能性要件，以及最佳模式 (best mode) 要件<sup>12</sup>。

1967 年，美國關務及專利上訴法院則首次由致能性要件分離出新的發明說明要件 (written description requirement 簡稱 WD requirement)，其立論在於每一專利制度均必須具有防止申請人於面對專利局之申請專利過程中藉修正程序 (amendment process) 更新 (update，或稱補充更新資料) 其揭示 (申請專利範圍或說明書) 之規定，否則，申請人可藉添加新事物 (new matter) 於其揭示，並準用原來提交之申請日 (original filing date)<sup>13</sup>；事實上，在此之前，添加新事物之核駁，係有法可稽，亦即美國專利法 132 條不得引入新事

物至發明之揭示之規定<sup>14</sup>，這種見解，係為優先權日之認定概念，當然此與主張優先權認定是否為相同之發明可謂異曲同工。

而於 1976 年之 *In re Wertheim* 案中<sup>15</sup>，則將此 WD 原則 (WD doctrine，亦即 written description doctrine) 認定為行使優先權之用，美國關務及專利上訴法院對於添加新事物 (adding new matter) 作了區別，而 USPTO 之實務則將添加新事物於申請專利範圍時係以專利法 132 條核駁 (rejection)，而添加新事物於說明書則以專利法 132 條反對 (objection，亦即異議或有意見)，顯然地，對於添加新事物於申請專利範圍，上訴法院已將之自專利法 112 條分離出來，而以專利法 132 條對待。不管如何，此 WD 原則開始具有很清楚的功能，亦即防止新事物混入申請專利範圍之修正中，當時 Rich 法官對 WD 之目的認定為：「發明說明要件之功能在於確保發明人於申請案之申請日基礎上，持有 (掌握) 其於稍後請求之特定主題標的 (specific subject matter)」<sup>16</sup>，所以，WD 係為新事物原則，其係守護優先權，這種認定持續一段時間，PTO 係以專利法 132 條為新事物之核駁，唯亦伴隨著發明說明之分析，亦即，專利法第 132 條及專利法 112 條兼用。

1981 年時，關務及專利上訴法院認為此兩者為可互換，其中，於 *In re Rasmussen* 案之判決中更直言：「本院述及，以專利法 132 條核駁修正之申請專利範圍等同 (equivalent to) 於以專利法 112 條第 1 項核駁<sup>17</sup>」，然而，為了避免新事物核駁及反對之混淆，CCPA 選擇捨棄 132/112 核駁，而代之以使用 112 條對申請專利範圍之新事物核駁，而於前揭 *In re Rasmussen* 案稱：「列述 (recite) 未能為原始揭示 (original disclosure) 所支持之元件之申請專利範圍修正之核駁，其合宜基礎為專利法 112 條第 1 項，而非專利法 132 條」<sup>18</sup>。

other things before known or used.”

<sup>9</sup> id. Thus, an adequate written description assures that others can “make and use” the invention.

<sup>10</sup> See *Evans v. Eaton*, 20 U.S. 356 (1822): [After enablement,] [t]he other object of the specification is to put the public in possession of what the party claims as his own invention, so as to ascertain if he claims any thing that is in common use, or is already known . . .

<sup>11</sup> “In addition [to novelty, utility, and nonobviousness], to obtain a utility patent, a breeder must describe the plant with sufficient specificity to enable others to ‘make and use’ the invention after the patent term expires.” *J.E.M. Ag. Supply, Inc. v. Pioneer Hi-Bred Int’l, Inc.*, 122 S.Ct. 593, 604 (2001).

<sup>12</sup> *In re Gay*, 309 F.2d 769, 772, 135 USPQ 311, 315 (CCPA, 1962).

<sup>13</sup> See *Enzo Biochem v. Gen-Probe, Inc.*, 296 F.3d 1316, 1324, 63 USPQ2d 1609, 1613 (Fed. Cir. 2002): In 1967, the Court of Customs and Patent Appeals first separated a new written description (WD) requirement from the enablement requirement of § 112. The reason for this new judge-made doctrine needs some explanation. Every patent system must have some provision to prevent applicants from using the amendment process to update their disclosures (claims or specifications) during their pendency before the patent office. Otherwise applicants could add new matter to their disclosures and date them back to their original filing date, thus defeating an accurate accounting of the priority of invention.

<sup>14</sup> 35 U.S.C. 132 Notice of rejection; reexamination

(a) . . . No amendment shall introduce new matter into the disclosure of invention.

<sup>15</sup> *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).

<sup>16</sup> “The function of the description requirement is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him.”

<sup>17</sup> “This court, ha[s] said that a rejection of an amended claim under § 132 is equivalent to a rejection under § 112, first paragraph.” *In re Rasmussen*, 650 F.2d 1212, 1214, 211 USPQ 323, 325 (CCPA, 1981)

<sup>18</sup> “The proper basis for rejection of a claim amended to recite elements thought to be without support in the original disclosure, therefore, is § 112, first paragraph, not § 132.” Id.

基本上，申請專利範圍係為說明書之一部份係為法律明文規定外，亦為許多判決所認可，如 1980 年之 *In re Koller* 案即稱：「原始之申請專利範圍構成其本身之發明說明(own description)」<sup>19</sup>，又如 1973 年之 *In re Gardner* 案稱：「...其顯然係為一原始申請專利範圍項，其本身構成了原始揭示之發明說明」<sup>20</sup>；另 2002 年之 *Enzo Biochem, Inc.* 案亦稱：「原始提交之申請專利範圍係為專利說明書(patent specification)之一部份」<sup>21</sup>。所以，2002 年美國最高法院於 *Festo* 案之判決中即：「專利申請案所請求者，必須相同於說明書(specification)所揭示者，否則專利不能被核准」<sup>22</sup>。而因為說明書(specification)將申請專利範圍視為一部份，其教示了經由所請求之發明所解決的問題，所請求之發明解決這些方法之方式，以及相關於該發明之先前技藝(prior art)<sup>23</sup>；因此，說明書亦會被用以限制申請專利範圍，而且，其不可被擴張<sup>24</sup>，也就是說，實務上，於申請專利時，當發明說明無法支持其申請專利範圍時，則可藉如實施例或實驗數據等輔強證據以支持，唯不得超出原揭示之範疇<sup>25</sup>，否則會被以新事物對待，這點亦可由手段加功能(means-plus-function)之撰寫方式得到證明，亦即，固然申請專利範圍依規

定無需列述該請求之特定功能之材料(material)、構造(structure)或動作(act)，唯若詳細說明中無對應之揭示(corresponding disclosure)時，此時不得准予專利，即使取得專利時，亦會變成無效<sup>26</sup>。

## (二)申請專利範圍

前已述及者，於 1793 年之美國專利法中並無申請專利範圍之要求，依現行美國專利法之第 112 條第 2 項之規定：「...一或以上申請專利範圍特定指出及清楚地請求發明人視為其發明之主題標的」，因此，固然發明必須被描述以及如何使其可實際實施之模式<sup>27</sup>，但是，是以申請專利範圍限定(measure，或稱量度)發明<sup>28</sup>，申請專利範圍之功能，係為(1)界定權利範疇；(2)告知社會大眾<sup>29</sup>。

專利之每一申請專利範圍項(請求項)構成了一分別之發明(separate invention，亦即不同之發明)<sup>30</sup>，此亦為吾人所熟知之「申請專利範圍項差異理論(doctrine of claim differentiation)」<sup>31</sup>，因此，每一申請專利範圍

<sup>19</sup> See, e.g., *In re Koller*, 613 F.2d 819, 823, 204 USPQ 702, 706 (CCPA 1980) (“[O]riginal claims constitute their own description.”);

<sup>20</sup> See *In re Gardner*, 475 F.2d 1389, 1391, 177 USPQ 396, 397 (CCPA 1973) (“Claim 2, which apparently was an original claim, in itself constituted a description in the original disclosure . . . .”).

<sup>21</sup> There is no question that an original claim is part of the specification. See *Enzo Biochem v. Gen-Probe, Inc.*, 296 F.3d 1316, 1324, 63 USPQ2d 1609, 1613 (Fed. Cir. 2002)

<sup>22</sup> What is claimed by the patent application must be the same as what is disclosed in the specification; otherwise the patent should not issue. See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S. Ct. 1831, 1840 (2002).

<sup>23</sup> The specification, of which the claims are part, teaches about the problems solved by the claimed invention, the way the claimed invention solves those problems, and the prior art that relates to the invention. . See *Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, 114 F.3d 1547, 1555-56, 42 USPQ2d 1737, 1742 (Fed. Cir. 1997);

<sup>24</sup> *McClain v. Ortmayer*, 141 U.S. 419, 424 (1891) (“The claim is the measure of his right to relief, and while the specification may be referred to to limit the claim, it can never be made available to expand it.”)

<sup>25</sup> That balance turns on how the specification characterizes the claimed invention. *SunRace Roots Enters. Co. v. SRAM Corp.*, 336 F.3d 1298, 1305 (Fed. Cir. 2003). Also see *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1345 (Fed. Cir. 2001) where the specification makes clear at various points that the claimed invention is narrower than the claim language might imply, it is entirely permissible and proper to limit the claims.

<sup>26</sup> See *Amtel Corp. v. Info. Storage Devices, Inc.*, 198 F.3d 1374, 1378-79, 53 USPQ2d 1225, 1227-28 (Fed. Cir. 1999). “[I]f one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by the claim language.” *Donaldson*, 16 F.3d at 1195, 29 USPQ2d at 1850 (emphasis added); see *Dossel*, 115 F.3d at 946, 42 USPQ2d at 1884 (“Failure to describe adequately the necessary structure, material, or acts [corresponding to a means-plus-function limitation] in the written description means that the drafter has failed to comply with § 112, ¶ 2.”).

<sup>27</sup> *Cont’l Paper Bag*, 210 U.S. at 419 (“The invention, of course, must be described and the mode of putting it to practical use, but the claims measure the invention.”);

<sup>28</sup> *Milcor Steel Co. v. George A. Fuller Co.*, 316 U.S. 143, 146 (1942) (“Out of all the possible permutations of elements which can be made from the specifications, he reserves for himself only those contained in the claims.”) (quoting *Milcor Steel Co. v. George A. Fuller Co.*, 122 F.2d 292, 294 (2d Cir. 1941)); *McClain v. Ortmayer*, 141 U.S. 419, 424 (1891) (“The claim is the measure of his right to relief, and while the specification may be referred to to limit the claim, it can never be made available to expand it.”); *SRI Int’l*, 775 F.2d at 1121, n.14 (“Specifications teach. Claims claim.”).

<sup>29</sup> See *Johnson & Johnston Associates v. R.E. Service Co.*, 285 F.3d 1046 (Fed. Cir. 2002) (en banc) Consistent with its scope definition and notice functions, the claim requirement presupposes that a patent applicant defines his invention in the claims, not in the specification.

<sup>30</sup> See, e.g., *Union Oil Co. of Cal. v. Atlantic Richfield Co.*, 208 F.3d 989, 54 USPQ2d 1227 (Fed. Cir. 2000). Also see *It is well-established that each claim in a patent constitutes a separate invention*, see, e.g., *Jones v. Hardy*, 727 F.2d 1524, 1528, 220 USPQ 1021, 1024 (Fed. Cir. 1984);

<sup>31</sup> Under the doctrine of claim differentiation, each claim in a patent is presumptively different in scope. *Comark*

項本身必須具有對應之發明說明<sup>32</sup>，更確切的說，「問題不在於每一申請專利範圍之限制條件(limitation)可於說明書中獲得支持，而是該請求之發明獲得支持」<sup>33</sup>。固然專利無需以精確地相同於用於申請專利範圍之用語以描述請求之發明之主題標的<sup>34</sup>，然而，必須用一些方式將其所有請求之限制條件描述該發明<sup>35</sup>；而是否精確地描述，則視個案(case-by-case)發展而定<sup>36</sup>，若詳細說明並未使用相同於申請專利範圍之精確用語，則須審究是否說明書可引導(directs)或指引(guides)熟習該項技藝人士至該請求之主題標的<sup>37</sup>，而若缺乏該特定引導時，則「一般性揭示(general disclosure)不足以支持較限縮請求之主題標的」<sup>38</sup>。

Communications, Inc. v. Harris Corp., 156 F.3d 1182, 1187, 48 USPQ2d 1001, 1005 (Fed. Cir. 1998).

<sup>32</sup> See, e.g., Union Oil Co. of Cal. v. Atlantic Richfield Co., 208 F.3d 989, 54 USPQ2d 1227 (Fed. Cir. 2000). Thus, a written description of the invention of each claim as such must be provided if the statutory requirement is to be met as to that claim.

<sup>33</sup> The question is not whether each of the claim limitations finds support in the specification but whether the inventions claimed, fuels having specific combinations of characteristics, finds such support. Id.

<sup>34</sup> It is true that a patent need not describe the claimed subject matter in precisely the same terms as used in the claims, see Vas-Cath, 935 F.2d at 1563-64, 19 USPQ2d at 1116;

<sup>35</sup> However, it must still describe the invention with all its claimed limitations in some manner, see Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997);

<sup>36</sup> In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1979). "Precisely how close the original description must come to comply with § 112 must be left to case-by-case development." Vas-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116 (citing In re Smith, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972)).

<sup>37</sup> If the written description does not use precisely the same terms used in a claim, the question then is whether the specification directs or guides one skilled in the art to the subject matter claimed. See, e.g., Fujikawa v. Wattanasin, 93 F.3d 1559, 1570, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996)

<sup>38</sup> See, e.g., Union Oil Co. of Cal. v. Atlantic Richfield Co., 208 F.3d 989, 54 USPQ2d 1227 (Fed. Cir. 2000). We have subsequently stated that without such specific direction, a general disclosure will not be sufficient to support narrowly claimed subject matter. See Fujikawa, 93 F.3d at 1571, 39 USPQ2d at 1905 ("In the absence of [ ] blazemarks [that the claimed compounds were of special interest], simply describing a large genus of compounds is not sufficient to satisfy the written description requirement as to particular species or subgenuses."). That direction must be expressed in "full, clear, concise, and exact" language. See Fields v. Conover, 443 F.2d 1386, 1391, 170 USPQ 276, 280 (CCPA 1971); In re Ahlbrecht, 435 F.2d 908, 911, 168 USPQ 293, 296 (CCPA 1971); Ruschig, 379 F.2d at 996, 154 USPQ at 123.

申請專利範圍之解讀起自申請專利範圍本身<sup>39</sup>，詳細說明，及若可為證據時之申請專利過程(prosecution history)<sup>40</sup>，實則，此解析之焦點必須起自且依然集中在申請專利範圍本身之文字，「因為該文字係專利權人選取並用以特定指出及明白請求其認定之發明之主題標的」<sup>41</sup>，所以，即使申請專利範圍包括了非必要絲毫不差(unnecessarily exact)的限制條件時，法院亦無權將之更正(correction)<sup>42</sup>，亦即，任何人，即使是法院都不能對申請專利範圍賦以異於(different than)專利權人本身所確立之意涵者<sup>43</sup>，因為，專利被核准後，申請專利過程告一段落，內部證據被固定(fixed)，公眾已被該核准之請求之專利所告知<sup>44</sup>，然而，若專利權人主張其可獲致數種目標時，則並不要求將每一申請專利範圍項須被解讀為限制在可獲致(achieve)所有目標之結構上<sup>45</sup>。

<sup>39</sup> First, we look to the claim language. See id.; Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999) ("The starting point for any claim construction must be the claims themselves."); Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 620, 34 USPQ2d 1816, 1819 (Fed. Cir. 1995) (noting first the mandate to consult the claims).

<sup>40</sup> Then we look to the rest of the intrinsic evidence, beginning with the specification and concluding with the prosecution history, if in evidence. See Vitronics, 90 F.3d at 1582, 39 USPQ2d at 1576-77 (delineating this order); Markman v. Westview Instruments, Inc., 52 F.3d 967, 979, 34 USPQ2d 1321, 1329 (Fed. Cir. 1995) ("Claims must be read in view of the specification, of which they are a part."), aff'd, 517 U.S. 370 (1996); Bell Communications, 55 F.3d at 620, 34 USPQ2d at 1819 (noting first the mandate to consult the claims, followed by inspection of the rest of the specification).

<sup>41</sup> "In construing claims, the analytical focus must begin and remain centered on the language of the claims themselves, for it is that language that the patentee chose to use to 'particularly point[ ] out and distinctly claim[ ] the subject matter which the patentee regards as his invention.'" 35 U.S.C. § 112, ¶ 2." Interactive Gift Express, Inc. v. Compuserve, Inc., 256 F.3d 1323, 1331, 59 USPQ2d 1401, 1406 (Fed. Cir. 2001).

<sup>42</sup> Talbert argues that the claims contain an unnecessarily exact boiling limit; if so, the court is without power to make such a correction.

<sup>43</sup> See Autogiro Company of America v. United States, 384 F.2d 391, 396 (Cl. Ct. 1967) ("Courts can neither broaden nor narrow the claims to give the patentee something different than what he has set forth.")

<sup>44</sup> See Texas Digital Systems, Inc. v. Telegenix, Inc., 308 F.3d 1193 (Fed. Cir. 2002). When a patent is granted, prosecution is concluded, the intrinsic record is fixed, and the public is placed on notice of its allowed claims.

<sup>45</sup> The fact that a patent asserts that an invention achieves several objectives does not require that each of the claims be construed as limited to structures that are capable of achieving all of the objectives. See Resonate Inc. v. Alteon Websystems, Inc., 338 F.3d 1360, 1367 (Fed. Cir. 2003); Northrop Grumman Corp. v. Intel Corp., 325 F.3d 1346, 1355 (Fed. Cir. 2003); Honeywell Inc. v. Victor Co. of Japan, Ltd., 298 F.3d 1317,

說明書與申請專利範圍之關係，或者說說明書對申請專利範圍之解讀之角色扮演之兩變生原則(twin axioms)係為，於一方面，申請專利範圍必須參酌說明書以解讀，因為申請專利範圍為說明書之一部份<sup>46</sup>；另一方面，不可將說明書之限制條件讀入(read into)申請專利範圍中<sup>47</sup>，而且，對該揭示之解讀必須以熟習該項技藝人士之知識(the knowledge of one skilled in the art)為之<sup>48</sup>，唯專家證人之陳述亦不得被用以「重撰(rewrite)或稱改寫」專利說明書以產生說明書文字未提及之確切連結(link)<sup>49</sup>；也就是說，無論如何，「發明說明並非非用以替代(substitute)，亦非被用以重寫該被選取之申請專利範圍文字」<sup>50</sup>。

申請專利範圍文字本身單獨而言，常不足以解決申請專利範圍解讀之爭議<sup>51</sup>，實則，即使申請專利範圍文字於表相上甚為清楚明白時，則對於其他內部證據(intrinsic evidence)之認定，係限制在認定是否與被限定之清楚與明白之申請專利範圍用語有所逸離(deviation)<sup>52</sup>，因為一般於解讀申請專利範圍時，會「強

烈推定(heavy presumption)」該申請專利範圍用語係為熟習該技藝人士所理解之通常意涵(ordinary meaning)<sup>53</sup>，然而，此推論可於兩種情況下被推翻，亦即，(1)當專利權人選擇其自己本身之編纂(lexicographer)<sup>54</sup>或(2)當申請專利範圍用語剝奪(deprive)申請專利範圍之明晰度，而請求之範疇無法經由申請專利範圍之文字所確定(ascertained)時<sup>55</sup>。所以，說明書通常是高度關連於(highly relevant to)申請專利範圍之解讀分析，其係為解決專利範圍用語爭議之意涵之最佳指引(guide)<sup>56</sup>。而對此「逸離」通常意涵之申請專利範圍之「再定義(redefine)」，則內部證據必須「明確地表示(plainly set forth)」或「明確地再定義(plainly redefine)」該申請專利範圍用語，以使合理地熟習該項技藝人士注意到專利權人企圖重新定義申請專利範圍用語<sup>57</sup>，而這種重新定義除了明示(explicit)外，亦可為隱喻(implication)<sup>58</sup>。

is specified. See *Interactive Gift Express, Inc. v. Compuserve Inc.*, 2001 WL 792669, \*7 (Fed. Cir. July 13, 2001).

<sup>53</sup> Generally, there is a "heavy presumption" in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art. *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

<sup>54</sup> A deviation may be necessary if "a patentee [has chosen] to be his own lexicographer and use terms in a manner other than their ordinary meaning." *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996).

<sup>55</sup> A deviation may also be necessary if a patentee has "relinquished [a] potential claim construction in an amendment to the claim or in an argument to overcome or distinguish a reference." *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 973, 979, 52 USPQ2d 1109, 1113 (Fed. Cir. 1999).

<sup>56</sup> Thus, the specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term." See *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996).

<sup>57</sup> See *Bell Atlantic Network Services, Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258, 59 USPQ2d 1865 (Fed. Cir. 2001). We have previously held that, in redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must "clearly set forth" or "clearly redefine" a claim term so as to put one reasonably skilled in the art on notice that the patentee intended to so redefine the claim term. *Elektra Instr. v. O.U.R. Scientific Int'l*, 214 F.3d 1302, 1307, 54 USPQ2d 1910, 1913 (Fed. Cir. 2000); *N. Telecom v. Samsung*, 215 F.3d 1281, 1287, 55 USPQ2d 1065, 1069 (Fed. Cir. 2000).

<sup>58</sup> See *Bell Atlantic Network Services, Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258, 59 USPQ2d 1865 (Fed. Cir. 2001). Indeed, we have specifically held that the written description of the preferred embodiments "can provide guidance as to the meaning of the claims, thereby dictating the manner in which the claims are to be construed, even if the guidance is not provided in explicit definitional format." *Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1344, 58 USPQ2d 1059, 1065 (Fed.

1325-26 (Fed. Cir. 2002).

<sup>46</sup> See *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898 (Fed. Cir. 2004). We have had many occasions to cite one or both of the twin axioms regarding the role of the specification in claim construction: On the one hand, claims "must be read in view of the specification, of which they are a part." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996).

<sup>47</sup> See *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898 (Fed. Cir. 2004). On the other hand, it is improper to read a limitation from the specification into the claims. *Arlington Indus., Inc. v. Bridgeport Fittings, Inc.*, 345 F.3d 1318, 1327 (Fed. Cir. 2003); *Gart v. Logitech, Inc.*, 254 F.3d 1334, 1343 (Fed. Cir. 2001).

<sup>48</sup> See *Atmel Corp. v. Info. Storage Devices, Inc.*, 198 F.3d 1374, 1380 (Fed. Cir. 1999) ("[I]nterpretation of what is disclosed must be made in light of the knowledge of one skilled in the art.");

<sup>49</sup> see also *Omega Eng'g, Inc. v. Raytek Corp.*, Nos. 01-1546, 02-1478, slip op. at 28-29 (Fed. Cir. July 7, 2003) (explaining that statements from experts cannot be used to "rewrite the patent's specification" to create a clear link where the language in the specification provides none); *Medtronic, Inc. v. Advanced Cardiovascular Sys., Inc.*, 248 F.3d 1303, 1313 (Fed. Cir. 2001) (finding particular structures not to be corresponding structures because "one skilled in the art would not perceive any clear link or association between these structures and the [recited] function of connecting adjacent elements together").

<sup>50</sup> See *Superguide Corp. v. DirectTV Enters.*, 358 F.3d 870, 888 n.14 (Fed. Cir. 2004). The written description, however, is not a substitute for, nor can it be used to rewrite, the chosen claim language.

<sup>51</sup> The claim language alone, however, does not settle the claim interpretation issue. See *Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, 114 F.3d 1547, 1555-56, 42 USPQ2d 1737, 1742 (Fed. Cir. 1997);

<sup>52</sup> If the claim language is clear on its face, then our consideration of the rest of the intrinsic evidence is restricted to determining if a deviation from the clear language of the claims

事實上，審查說明書之目的之一在於認定是否專利權人限制了其請求之範疇<sup>59</sup>，所以，當說明書與很清楚地表示該發明並不包括一特定之特徵(feature)時，該特徵被視為在該專利之請求所及之外，即使在該申請專利範圍用語，於未參酌說明書解讀之下，可能被認定寬廣至足以包括該特徵時亦然<sup>60</sup>；相同地，專利權人可能於申請過程中以不請求該特定特徵之方式，限制申請專利範圍之範疇<sup>61</sup>，所以，揭示於說明書中唯未請求於申請專利範圍者，被視為貢獻給公眾(dedicate to the public)<sup>62</sup>，亦即所謂的「揭示-貢獻原則(disclosure-dedication rule)」<sup>63</sup>，於Mahn案，最高法院作了如下的解釋：

「當然，未請求者係為公共財產(public property)，此推定係為，且此通常亦為事實者，未請求者並非專利權人所發明者，而是於其作出發明前已被知悉且使用者，但是，不管是否如此，先前若非如此的話，則其自己本身行為亦已使其成為公共財產，專利本身，於其被核准授予後，係為證據，公眾具有

無可疑問的使用權，且被推定為對專利中未特定請求者具如此之使用權<sup>64</sup>」。

除了參酌說明書外，亦應審查專利申請過程以認定是否專利權人為了克服(overcome)或區別(distinguish)引證之前案而對申請專利範圍修正或抗辯，因而放棄了潛在的申請專利範圍解讀(potential claim construction)<sup>65</sup>，內部證據之解讀始於說明書，若可為證據的話，則與申請專利過程為結論<sup>66</sup>；若申請專利範圍之限制條件於參酌內部證據即可明白得知時，則無需再藉助外部證據(extrinsic evidence)<sup>67</sup>，也就是說，僅在當申請專利範圍文字於認定內部證據後依然真正地不明確時，仰賴外部證據方為合宜(proper)<sup>68</sup>，而這種情形，即使有的話，亦鮮少發生<sup>69</sup>。總而言之，內部證據所提供之客觀且當時(contemporaneous)之記錄，係為認定專利權人賦予該爭議限制條件之意欲意

Cir. 2001). In other words, the specification may define claim terms "by implication" such that the meaning may be "found in or ascertained by a reading of the patent documents." Vitronics, 90 F.3d at 1582, 1584 n.6, 39 USPQ2d at 1577, 1578 n.6.

<sup>59</sup> "[o]ne purpose for examining the specification is to determine if the patentee has limited the scope of the claims." Watts v. XL Sys., Inc., 232 F.3d 877, 882 (Fed. Cir. 2000).

<sup>60</sup> When the specification "makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question." SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc., 242 F.3d 1337, 1341 (Fed. Cir. 2001).

<sup>61</sup> When the specification "makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question." SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc., 242 F.3d 1337, 1341 (Fed. Cir. 2001).

<sup>62</sup> See Johnson & Johnston, 285 F.3d 1046 (Fed. Cir. 2002) (en banc); Maxwell v. J. Baker, Inc., 86 F.3d 1098, 1106-08 (Fed. Cir. 1996) when a patent drafter discloses but declines to claim subject matter . . . this action dedicates that unclaimed subject matter to the public. Application of the doctrine of equivalents to recapture subject matter deliberately left unclaimed would "conflict with the primacy of the claims in defining the scope of the patentee's exclusive right."

<sup>63</sup> See, e.g., PSC Computer Prods., Inc. v. Foxconn Int'l, Inc., 355 F.3d 1353, 1356-57 (Fed. Cir. 2004) The disclosure-dedication rule requires an inventor who discloses specific matter to claim it, and to submit the broader claim for examination. Otherwise, that matter is dedicated to the public and may not be recaptured under the doctrine of equivalents.

<sup>64</sup> See, e.g., Mahn v. Harwood, 112 U.S. 354, 361 (1884) Of course, what is not claimed is public property. The presumption is, and such is generally the fact, that what is not claimed was not invented by the patentee, but was known and used before he made his invention. But, whether so or not, his own act has made it public property if it was not so before. The patent itself, as soon as it is issued, is the evidence of this. The public has the undoubted right to use, and it is to be presumed does use, what is not specifically claimed in the patent.

<sup>65</sup> Moreover, we must also examine the prosecution history to determine whether the patentee has relinquished a potential claim construction in an amendment to the claim or in an argument to overcome or distinguish a reference. Southwall Techs., Inc. v. Cardinal IG, Co., 54 F.3d 1570, 1576, 34 USPQ2d 1673, 1676 (Fed. Cir. 1995);

<sup>66</sup> See Interactive Gift Express, Inc. v. CompuServe Inc., 2001 WL 792669, \*7 (Fed. Cir. July 13, 2001). "Then we look to the rest of the intrinsic evidence, beginning with the specification and concluding with the prosecution history, if in evidence. See Markman v. Westview Instruments, Inc., 52 F.3d 967, 979, 34 USPQ2d 1321, 1329 (Fed. Cir. 1995) ("Claims must be read in view of the specification, of which they are a part."), aff'd, 517 U.S. 370 (1996); Bell Communications, 55 F.3d at 620, 34 USPQ2d at 1819 (noting first the mandate to consult the claims, followed by inspection of the rest of the specification)".

<sup>67</sup> If the meaning of the claim limitations is apparent from the totality of the intrinsic evidence, then the claim has been construed. If however a claim limitation is still not clear, we may look to extrinsic evidence to help resolve the lack of clarity. Id.

<sup>68</sup> Relying on extrinsic evidence to construe a claim is "proper only when the claim language remains genuinely ambiguous after consideration of the intrinsic evidence." Bell & Howell Document Mgmt. Prods. Co. v. Altek Sys., 132 F.3d 701, 706, 45 USPQ2d 1033, 1038 (Fed. Cir. 1997); see also Helifix Ltd. v. Blok-Lok, Ltd., 208 F.3d 1339, 1346, 54 USPQ2d 1299, 1303 (Fed. Cir. 2000); Key Pharms. v. Hercon Lab. Corp., 161 F.3d 709, 716, 48 USPQ2d 1911, 1917 (Fed. Cir. 1998).

<sup>69</sup> See Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996). "Such instances will rarely, if ever, occur."

涵之最可靠指引<sup>70</sup>；需注意者，除非另有強制，否則必須賦予申請專利範圍用語以熟習該項技藝人士所能解讀之所有範疇(full range)<sup>71</sup>，如說明書僅描述單一實施例(embodiment)時，則並不要求每一申請專利範圍項(請求項)被限制在該單一實施例<sup>72</sup>，尤其是，申請專利範圍項並不必然限制在揭示於專利中之較佳實施例(preferred embodiment)<sup>73</sup>。

而外部證據只可被用以協助對爭議之限制條件之合宜理解(understanding)<sup>74</sup>，其不得被用以不同，矛盾，擴張及限制於說明書或申請專利範圍所定義用語者<sup>75</sup>。

長久以來，字典、百科全書及論文被特定使用為協助認定申請專利範圍用語之通常與慣常意涵(ordinary and customary meaning)<sup>76</sup>，尤其是字典<sup>77</sup>，因為這些於專利被核准時業已為公眾可致(publicly available)者，係可作為可信賴資訊之客觀來源(object resources)<sup>78</sup>，而若字典中對用語具多重定義(multiple definition)時，則必須參酌內部證據以辨識何者最符合申請人所使用之文字意涵<sup>79</sup>，若有一個以上之字典定義符合於內部證據之文字使用時，則申請專利範圍用語可被能解讀為包含所有該符合之意涵<sup>80</sup>。總之，外部證據不得被仰賴為不同或矛盾於申請專利範圍之

<sup>70</sup> See *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002). The objective and contemporaneous record provided by the intrinsic evidence is the most reliable guide to help the court determine which of the possible meanings of the terms in question was intended by the inventor to particularly point out and distinctly claim the invention. Also see *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998) (“The construction that stays true to the claim language and most naturally aligns with the patent’s description of the invention will be, in the end, the correct construction.”).

<sup>71</sup> *Id.* Moreover, unless compelled otherwise, a court will give a claim term the full range of its ordinary meaning as understood by persons skilled in the relevant art. Quoting *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001); *Johnson Worldwide Assocs.*, 175 F.3d at 989, 50 USPQ2d at 1610; *Specialty Composites*, 845 F.2d at 986, 6 USPQ2d at 1604.

<sup>72</sup> *Id.* For example, if an invention is disclosed in the written description in only one exemplary form or in only one embodiment, the risk of starting with the intrinsic record is that the single form or embodiment so disclosed will be read to require that the claim terms be limited to that single form or embodiment.

<sup>73</sup> See *Transmatic, Inc. v. Gulton Indus., Inc.*, 53 F.3d 1270, 1277, 35 USPQ2d 1035, 1040-41 (Fed. Cir. 1995) (“[A] patent claim is not necessarily limited to a preferred embodiment disclosed in the patent.”); Also see *SRI Int'l, Inc. v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 n.14, 227 USPQ 577, 585 n.14 (Fed. Cir. 1985) (en banc) (“That a specification describes only one embodiment does not require that each claim be limited to that one embodiment.”).

<sup>74</sup> See *Interactive Gift Express, Inc. v. Compuserve Inc.*, 2001 WL 792669, \*7 (Fed. Cir. July 13, 2001). Extrinsic evidence may always be consulted, however, to assist in understanding the underlying technology. Also See *Pitney Bowes*, 182 F.3d at 1309, 51 USPQ2d at 1168 (“[C]onsultation of extrinsic evidence is particularly appropriate to ensure that [a judge’s] understanding of the technical aspects of the patent is not entirely at variance with the understanding of one skilled in the art.”); *Mantech Envtl. Corp. v. Hudson Envtl. Servs., Inc.*, 152 F.3d 1368, 1373, 47 USPQ2d 1732, 1737 (Fed. Cir. 1998);

<sup>75</sup> *Id.* But extrinsic evidence may never be used “for the purpose of varying or contradicting the terms in the claims.” Also see *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373 (Fed. Cir. 2003) Extrinsic evidence may never be relied upon, however, to vary or contradict the clear meaning of terms in the claims. Quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 981, 34 USPQ2d 1321, 1331 (Fed. Cir. 1995) (en banc), *aff’d*, 517 U.S. 370 (1996).

<sup>76</sup> See *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002). It has been long recognized in our precedent and in the precedent of our predecessor court, the Court of Customs and Patent Appeals, that dictionaries, encyclopedias and treatises are particularly useful resources to assist the court in determining the ordinary and customary meanings of claim terms. Also see *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1380 (Fed. Cir. 2002) (“The ordinary meaning of a claim term may be determined by reviewing a variety of sources, including . . . dictionaries and treatises . . .” (internal citations omitted));

<sup>77</sup> *Id.* Dictionaries are always available to the court to aid in the task of determining meanings that would have been attributed by those of skill in the relevant art to any disputed terms used by the inventor in the claims. Also see *Vitronics Corp. v. Conception, Inc.*, 90 F.3d 1576, 1584 n.6, 39 USPQ2d 1573, 1578 n.6 (Fed. Cir. 1996) (“[T]echnical treatises and dictionaries . . . are worthy of special note. Judges are free to consult such resources at any time . . . and may also rely on dictionary definitions when construing claim terms . . .”); *Cybor Corp.*, 138 F.3d at 1459, 46 USPQ2d at 1177 (citing *Vitronics* for the proposition that a court is free to consult dictionaries, encyclopedias, and treatises at any time to help determine the meaning of claim terms); *Vanguard Prods. Corp. v. Parker Hannifin Corp.*, 234 F.3d 1370, 1372, 57 USPQ2d 1087, 1089 (Fed. Cir. 2000) (“A dictionary is not prohibited extrinsic evidence, and is an available resource of claim construction.”).

<sup>78</sup> *Id.* Dictionaries, encyclopedias and treatises, publicly available at the time the patent is issued, are objective resources that serve as reliable sources of information on the established meanings that would have been attributed to the terms of the claims by those of skill in the art. Such references are unbiased reflections of common understanding not influenced by expert testimony or events subsequent to the fixing of the intrinsic record by the grant of the patent, not colored by the motives of the parties, and not inspired by litigation.

<sup>79</sup> Because words often have multiple dictionary definitions, some having no relation to the claimed invention, the intrinsic record must always be consulted to identify which of the different possible dictionary meanings of the claim terms in issue is most consistent with the use of the words by the inventor. See *Dow Chem. Co. v. Sumitomo Chem. Co.*, 257 F.3d 1364, 1372-73, 59 USPQ2d 1609, 1614 (Fed. Cir. 2001); *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1478, 45 USPQ2d 1429, 1433 (Fed. Cir. 1998).

<sup>80</sup> See *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) If more than one dictionary definition is consistent with the use of the words in the intrinsic record, the claim terms may be construed to encompass all such consistent meanings.

用語之清楚意涵<sup>81</sup>，所以，當內部證據顯示說明書以不符合於字典定義之方式使用時，則該不符合於說明書之字典定義即不得採用<sup>82</sup>，也就是說，字典定義可被專利權人自行編纂且明確表示之意涵所推翻<sup>83</sup>。

總結而論，美國最高法院於 1878 年對 *Bates v. Coe* 案之判決中即明白述及：精確的發明說明具有三種目的，即(1)政府知道其所核准且到期後會變成公共財產的專利為何；(2)有意實施該發明之被授權人於授權期間內知道如何製造，建構及使用該發明；及(3)其他發明人可以知道該發明領域(field of the invention)之那一部份未被佔有(unoccupied)<sup>84</sup>。尤有進者，專利之申請專利範圍與發明說明之關係，或許可由美國最高法院長久以來之見解以闡述對美國專利法 112 條所闡述之見解作一結論，如 1880 年之 *Burns* 案所述：「當專利之申請專利範圍限制發明時，說明書不能被用以擴張(expand)其專利獨占<sup>85</sup>」；又如 1871 年之 *Seymour* 案所稱：「基本上，申請專利範圍必須睽諸於說明書被解讀，且兩者必須以於確認發明之觀點下被閱讀」<sup>86</sup>。

<sup>81</sup> See *Bell Atlantic Network Services, Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258, 59 USPQ2d 1865 (Fed. Cir. 2001). This extrinsic evidence may be used only to assist in the proper understanding of the disputed limitation; it may not be used to vary, contradict, expand, or limit the claim language from how it is defined, even by implication, in the specification or file history.

<sup>82</sup> See *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002) Indeed, the intrinsic record may show that the specification uses the words in a manner clearly inconsistent with the ordinary meaning reflected, for example, in a dictionary definition. In such a case, the inconsistent dictionary definition must be rejected.

<sup>83</sup> *Id.* In short, the presumption in favor of a dictionary definition will be overcome where the patentee, acting as his or her own lexicographer, has clearly set forth an explicit definition of the term different from its ordinary meaning. See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992).

<sup>84</sup> Accurate description of the invention is required by law, for several important purposes: 1. That the government may know what is granted, and what will become public property when the term of the monopoly expires. 2. That licensed persons desiring to practise the invention may know during the term how to make, construct, and use the invention. 3. That other inventors may know what part of the field of invention is unoccupied. See *Bates v. Coe*, 98 U.S. 31, 39 (1878).

<sup>85</sup> While the claims of a patent limit the invention, and specifications cannot be utilized to expand the patent monopoly, *Burns v. Meyer*, 100 U.S. 671, 672 (1880); Also see *McCarty v. Lehigh Valley R. Co.*, 160 U.S. 110, 116 (1895).

<sup>86</sup> it is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention, *Seymour v. Osborne*, 11 Wall. 516, 547 (1871); Also see *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211 (1940); *Schering Corp. v. Gilbert*, 153 F.2d 428 (1946). *United States v. Adams*, 383 U.S. 39, 48-49 (1966).

## 參、均等論與禁反言

### 一、均等論之起源

一般認為是 1853 年之 *Winan* 案<sup>87</sup>，該案係涉及運煤車之設計，專利之運煤車採用圓錐體面平削之方式，免除習知之長方體側壁必須補強之缺失，而被控侵權之運煤車採八角形設計，最高法院推翻原本不涉侵權之判決，並以今日所稱之均等論之觀點認定侵權，其論點為：若公眾自由地從事實質的翻製，只是形式(form)與比例(proportions)不同，則對專利物品之專有權(exclusive right)無法確保<sup>88</sup>。

而後於 1877 年之 *Union Paper Bag Machine Co.*，案<sup>89</sup>則建立了後來所習稱之所謂功能-方式-結果(function-way-result)之三部辨識檢測(triple identity test)<sup>90</sup>或三部檢測(tripartite test)<sup>91</sup>。該案涉及之專利係為切紙裝置，最高法院稱：「一般說來，若其以實質相同(substantially the same)之方式(way)，執行實質相同之功能(function)，並獲致實質相同結果(result)時，則已侵害另一裝置」。<sup>92</sup>

1929 年之 *Sanitary Refrigerator Co.*，案係為有關冰箱門門之案件，亦引用 *Union Paper Bag Machine Co.*，案之判決<sup>93</sup>。

而後，於 1950 年 *Graver Tank* 案<sup>94</sup>，亦即所謂的現代均等論(modern doctrine of equivalents)<sup>95</sup>，則再度強化

<sup>87</sup> *Winans v. Denmead*, 56 U.S. 330 (1853).

<sup>88</sup> "the exclusive right to the thing patented is not secured, if the public are at liberty to make substantial copies of it, varying its form or proportions." *Id.*

<sup>89</sup> *Union Paper Bag Machine Co. v. Murphy*, 97 U. S. (7 Otto) 120, 125 (1877).

<sup>90</sup> See *Wright Med. Tech., Inc. v. Osteonics Corp.*, 122 F.3d 1440, 1445, 43 USPQ2d 1837, 1841 (Fed. Cir. 1997). ("There seems to be substantial agreement that, while the triple identity test may be suitable for analyzing mechanical devices, it often provides a poor framework for analyzing other products or processes.")

<sup>91</sup> See *Dawn Equipment Co. v. Kentucky Farms, Inc.*, 140 F.3d 1009, 46 USPQ2d 1109 (Fed. Cir. 1998), it is difficult to understand why the tripartite test would not also be available to resolve the question of insubstantial changes under the statute.

<sup>92</sup> generally speaking, one device is an infringement of another "if it performs substantially the same function in substantially the same way to obtain the same result" See *Union Paper Bag Machine Co. v. Murphy*, 97 U. S. (7 Otto) 120, 125 (1877).

<sup>93</sup> *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 42 (1929).

<sup>94</sup> *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 85 USPQ328 (1950).

<sup>95</sup> The Supreme Court first applied the modern doctrine of

了此見解，該案係涉及電焊之焊藥材料選擇，最高法院稱：「均等論之本質係為防止專利上之詐欺」<sup>96</sup>，同時，將原有之功能-方式-結果外，再加上可互換性(interchangeability)要件<sup>97</sup>，並稱：「重要的因素係為是否合理的熟習該項技藝人士會知道對未包括(not contained)亦即未請求之成份，互換為專利請求者」<sup>98</sup>。

其後兩年，亦即 1952 年，美國專利法條正，將手段加功能首次入法，且專利法中亦首次出現「均等」用語<sup>99</sup>，固然其並非均等論之立論所在，唯此後均等論乃成為專利侵權訴訟探究之課題，當然，亦有判決認為均等論較適宜分析機構裝置，而拙於分析物品或方法之專利侵權<sup>100</sup>。

到了 1997 年之 Warner-Jenkinson 案，則對均等論起了很大的變化，最高法院對均等論之適用背書(endorsed)，並認為其已走出自己的一條路，而並不被束縛在專利之申請專利範圍內<sup>101</sup>，而且，均等論下侵

權係為事實問題(matter of fact)<sup>102</sup>，且必須於逐一元件基礎(element-by-element basis)<sup>103</sup>，或逐一限制條件基礎(limitation-by-limitation basis)下為之<sup>104</sup>，這也呼應了 1994 年 Dolly 案所稱：均等論並非忽略(ignore)申請專利範圍之限制條件之執照(license，或稱許可)<sup>105</sup>，同時，也首次使用「非實質差異(insubstantial difference，或稱非實質不同)」<sup>106</sup>，此也呼應了前述 Graver Tank 案所稱：「非實質改變(insubstantial change)」<sup>107</sup>。而對於所謂「非實質不同」，聯邦巡迴上訴法院仍將之訴諸於傳統之功能-方式-結果之公式上<sup>108</sup>。且對於用以阻卻均等論之申請過程禁反言(prosecution history estoppel)，則仍繼續適用<sup>109</sup>，而且，進一步判定，申請過程之禁反言，係

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equivalents in Graver Tank & Mfg. Co. v. Linde Air Prods. Co. (Graver II). See Johnson & Johnston Associates v. R.E. Service Co., 285 F.3d 1046 (Fed. Cir. 2002) (en banc).

<sup>96</sup> "the essence of the doctrine of equivalents is that one may not practice a fraud on the patent." See Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 339 U.S. 605, 85 USPQ328 (1950).

<sup>97</sup> See Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., Inc., 145 F.3d 1303, 46 USPQ2d 1752 (Fed. Cir. 1998). The question of known interchangeability is not whether both structures serve the same function, but whether it was known that one structure was an equivalent of another. Moreover, a finding of known interchangeability, while an important factor in determining equivalence, is certainly not dispositive. See, e.g., Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 339 U.S. 605, 609, 85 USPQ 328, 331 (1950).

<sup>98</sup> See, e.g., Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 339 U.S. 605, 609, 85 USPQ 328, 331 (1950) (stating in reference to the doctrine of equivalents that consideration "must be given to the purpose for which an ingredient is used in a patent, the qualities it has when combined with the other ingredients, and the function which it is intended to perform. An important factor is whether persons reasonably skilled in the art would have known of the interchangeability of an ingredient not contained in the patent with one that was.").

<sup>99</sup> See 35 U.S.C. 112 (6): An element in a claim...cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

<sup>100</sup> See Wright Med. Tech., Inc. v. Osteonics Corp., 122 F.3d 1440, 1445, 43 USPQ2d 1837, 1841 (Fed. Cir. 1997). ("There seems to be substantial agreement that, while the triple identity test may be suitable for analyzing mechanical devices, it often provides a poor framework for analyzing other products or processes."). citing Warner-Jenkinson, 117 S. Ct. at 1054, 41 USPQ2d at 1875.

<sup>101</sup> See Loral Fairchild Corp. v. Sony Corp., 181 F.3d 1313, 1322, 50 USPQ2d 1865, 1870-71 (Fed. Cir. 1999). In Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17 (1997), the Supreme Court endorsed the continued vitality of the doctrine of equivalents. Because the doctrine of equivalents "has taken on a life of its own, unbounded by the patent claims,"

<sup>102</sup> Infringement under the doctrine of equivalents is a question of fact. Warner-Jenkinson, 520 U.S. at 38.

<sup>103</sup> See Loral Fairchild Corp. v. Sony Corp., 181 F.3d 1313, 1322, 50 USPQ2d 1865, 1870-71 (Fed. Cir. 1999). "the Court held that the doctrine must be applied as an objective inquiry on an element-by-element basis.

<sup>104</sup> See Texas Instruments Inc. v. Cypress Semiconductor Corp., 90 F.3d 1558, 1563, 39 USPQ2d 1492, 1496 (Fed. Cir. 1996). In particular, we did not eliminate the need to prove equivalency on a limitation-by-limitation basis. See Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, 935, 4 USPQ2d 1737, 1739-40 (Fed. Cir. 1987) (in banc), cert. denied, 485 U.S. 961 (1988); / see also Athletic Alternatives, Inc. v. Prince Mfg., Inc., 73 F.3d 1573, 1582, 37 USPQ2d 1365, 1373 (Fed. Cir. 1996) (applying the Pennwalt rule after our in banc decision in Hilton Davis).

<sup>105</sup> See Dolly, Inc. v. Spalding & Evenflo Cos., 16 F.3d 394, 400, 29 USPQ2d 1767, 1771 (Fed. Cir. 1994). "The doctrine of equivalents is not a license to ignore claim limitations."

<sup>106</sup> See Hilton Davis Chem. Co. v. Warner-Jenkinson Co., 62 F.3d 1512, 1521-22, 35 USPQ2d 1641, 1648 (Fed. Cir. 1995) (en banc) (holding that "a finding of infringement under the doctrine of equivalents requires proof of insubstantial differences between the claimed and accused products").

<sup>107</sup> "[T]o permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing . . . leav[ing] room for - indeed encourag[ing] - the unscrupulous copyist to make unimportant and insubstantial changes." Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 339 U.S. 605, 607 (1950).

<sup>108</sup> See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 234 F.3d 558 (Fed. Cir. 2000) (en banc). In an attempt to make the phrase "insubstantial differences" less indeterminate, we have continued to resort to the old "function-way-result" formulation, indicating that in appropriate cases—whatever that might mean—the answer could be found through those lenses. e.g., Hill-Rom Co. v. Kinetic Concepts, Inc., 209 F.3d 1337, 1343, 54 USPQ2d 1437, 1442 (Fed. Cir. 2000); Kraft Foods, Inc. v. Int'l Trading Co., 203 F.3d 1362, 1371, 53 USPQ2d 1814, 1820-21 (Fed. Cir. 2000); Overhead Door Corp. v. Chamberlain Group, Inc., 194 F.3d 1261, 1270, 52 USPQ2d 1321, 1327 (Fed. Cir. 1999); Augustine Medical, Inc. v. Gaymar Indus., Inc., 181 F.3d 1291, 1304, 50 USPQ2d 1900, 1909 (Fed. Cir. 1999); Vehicular Tech. Corp. v. Titan Wheel Int'l, Inc., 141 F.3d 1084, 1089-90, 46 USPQ2d 1257, 1261 (Fed. Cir. 1998); Dawn Equip. Co. v. Kentucky Farms Inc., 140 F.3d 1009, 1015-16, 46 USPQ2d 1109, 1113 (Fed. Cir. 1998).

<sup>109</sup> See Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520

為專利權人不能經由均等論再請求(reclaim)為了獲得專利而被拋棄(surrendered)或放棄(disclaimed)部份<sup>110</sup>，亦即，申請專利過程之禁反言適用於因克服專利要件核駁(overcome patentability rejection)而修正結果下被拋棄的部份<sup>111</sup>，當然這也適用於為了確保申請專利範圍核准而於抗辯(argument，或稱答辯)時被拋棄的部份<sup>112</sup>；同時，也明確地判定專利權人對於不明原因之修正，可經由抗辯以推翻禁反言，亦即所謂的「可被抗辯之推論(rebuttable presumption)」<sup>113</sup>。

這件判決引起了重大震撼，而於 1999 年之 Festo 案<sup>114</sup>中，CAFC 特別對各造提出五個問題，要求提供意見，亦即：(1)涉及可專利性理由是否限於專利法 102 條及第 103 條<sup>115</sup>，或包括足以影響獲得專利之任何理由；(2)自發性之申請專利範圍修正(voluntary claim amendment，或稱自願性修正)是否會引致申請過程

之禁反言<sup>116</sup>；(3)若引致禁反言，則該被修正之申請專利範圍限制條件，是否具均等之範疇(range)?<sup>117</sup>；(4)修正後之申請專利範圍元件，其均等之範疇為何<sup>118</sup>；及(5)本案之判決是否會抵觸「全要件原則(all elements rule)」<sup>119</sup>?

於 2000 年 11 月 29 日之聯席審判(en banc)中<sup>120</sup>，則作出了涉及法律要件之任何理由而為之限縮修正，都會使該被修正過之元件引致申請過程之禁反言之結論<sup>121</sup>；對涉及專利之法律要件而為之自發性修正，則該被修正元件亦會引致禁反言<sup>122</sup>；因修正而引起之申請過程禁反言使該被修正之元件無均等範疇(no range of equivalents)，亦即完全阻卻(complete bar)<sup>123</sup>；對未說明理由之申請專利範圍修正(no explanation for a claim amendment)，亦無任何均等範疇<sup>124</sup>；然而，對於是否違反全要件原則部份，則擇日再於其他案件中討論<sup>125</sup>。Newman 法官則獨排眾議，認為

U.S. 17 (1997), Prosecution history estoppel continues to be available as a defense to infringement . . .

<sup>110</sup> Id. The touchstone of prosecution history estoppel is that a patentee is unable to reclaim through the doctrine of equivalents what was surrendered or disclaimed in order to obtain the patent. See also *Cybor Corp. v. FAS Tech. Inc.*, 138 F.3d 1448, 1460, 46 USPQ2d 1169, 1178 (Fed. Cir. 1998) (in banc); *Hughes Aircraft Co. v. United States*, 140 F.3d 1470, 1476, 46 USPQ2d 1285, 1290 (Fed. Cir. 1998); *Litton Systems, Inc. v. Honeywell, Inc.*, 140 F.3d 1449, 1456, 46 USPQ2d 1321, 1325 (Fed. Cir. 1998); *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1219, 36 USPQ2d 1225, 1231 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 1243 (1997).

<sup>111</sup> Id. Prosecution history estoppel applies to matter surrendered as a result of amendments to overcome patentability rejections.

<sup>112</sup> See *Loral Fairchild Corp. v. Sony Corp.*, 181 F.3d 1313, 1322, 50 USPQ2d 1865, 1870-71 (Fed. Cir. 1999) " . . . and as a result of argument to secure allowance of a claim" . . . See, e.g., *Wang, Lab., Inc. v. Mitsubishi Elec., Inc.*, 103 F.3d 1571, 1578, 41 USPQ2d 1263, 1269 (Fed. Cir. 1997); *Hoganas AB v. Dresser Indus., Inc.*, 9 F.3d 948, 952, 28 USPQ2d 1936, 1939 (Fed. Cir. 1993); *Texas Instruments Inc., v. United States Int'l Trade Comm'n*, 988 F.2d 1165, 1174-75, 26 USPQ2d 1018, 1025 (Fed. Cir. 1993).

<sup>113</sup> Id. In its analysis of prosecution history estoppel, the Supreme Court in *Warner-Jenkinson* articulated a rebuttable presumption that arises whenever an amendment to a claim is made but the reason for that amendment is not shown by the patentee. Also see Thus, adoption of a rebuttable presumption of estoppel for an amendment that was made for an unknown reason necessarily presupposes the possibility that no estoppel will apply where the reason for the amendment is known, or where the presumption is rebutted. See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558 (Fed. Cir. 2000) (en banc).

<sup>114</sup> *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 187 F.3d 1381, 1381-82, 51 USPQ2d 1959, 1959-60 (Fed. Cir. 1999) ("Festo V").

<sup>115</sup> 1. For the purposes of determining whether an amendment to a claim creates prosecution history estoppel, is "a substantial reason related to patentability," *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 33, 117 S. Ct. 1040, 137 L. Ed. 2d 146 (1997), limited to those amendments made to overcome prior art under § 102 and § 103, or does "patentability" mean any reason affecting the issuance of a patent?

<sup>116</sup> 2. Under *Warner-Jenkinson*, should a "voluntary" claim amendment—one not required by the examiner or made in response to a rejection by an examiner for a stated reason—create prosecution history estoppel?

<sup>117</sup> 3. If a claim amendment creates prosecution history estoppel, under *Warner-Jenkinson* what range of equivalents, if any, is available under the doctrine of equivalents for the claim element so amended?

<sup>118</sup> 4. When "no explanation [for a claim amendment] is established," *Warner-Jenkinson*, 520 U.S. at 33, 117 S. Ct. 1040, thus invoking the presumption of prosecution history estoppel under *Warner-Jenkinson*, what range of equivalents, if any, is available under the doctrine of equivalents for the claim element so amended?

<sup>119</sup> 5. Would a judgment of infringement in this case violate *Warner-Jenkinson's* requirement that the application of the doctrine of equivalents "is not allowed such broad play as to eliminate [an] element in its entirety," 520 U.S. at 29, 117 S. Ct. 1040. In other words, would such a judgment of infringement, post *Warner-Jenkinson*, violate the "all elements" rule?

<sup>120</sup> *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 563 (Fed. Cir. 2000) (en banc) ("Festo VI").

<sup>121</sup> Id. "a narrowing amendment made for any reason related to the statutory requirements for a patent will give rise to prosecution history estoppel with respect to the amended claim element."

<sup>122</sup> Id. "a voluntary amendment that narrows the scope of a claim for a reason related to the statutory requirements for a patent will give rise to prosecution history estoppel as to the amended claim element" .

<sup>123</sup> Id. "Application of the doctrine of equivalents to the claim element is completely barred (a "complete bar")" .

<sup>124</sup> Id. "When no explanation for a claim amendment is established, no range of equivalents is available for the claim element so amended" .

<sup>125</sup> Id. "We do not need to reach this question for reasons which will become clear in our discussion of the specific case before us. Accordingly, we leave for another day any discussion of the "all elements" rule" .

這種「完全阻卻」方式會影響即存之專利，因此，應採個案認定之「彈性阻卻(flexible bar)」<sup>126</sup>。

隨後最高法院於移送上訴後作出判決<sup>127</sup>，認為(1)涉及可專利性而限縮修正(narrowing amendment)會引致申請過程之禁反言<sup>128</sup>。(2)不同意採取全面阻卻<sup>129</sup>。同時認定涉及專利要件之限縮修正，拋棄了原申請專利範圍限制條件與修正後之申請專利範圍限制條件間之所有領域(territory)<sup>130</sup>；但是，專利權人可經由證明於修正當時一熟習該項技藝人士不會被合理的期待(reasonably be expected to)撰寫會文義包含(literally encompassed)該主張均等之申請專利範圍以推翻該推定<sup>131</sup>，並列舉了三種方式，如(1)於修正當時該均等為不可預見(unforeseeable)時<sup>132</sup>；(2)合理推論該修正無關乎(tangential relation to)系爭均等<sup>133</sup>；及(3)建議專利權人不會被合理期望撰寫該爭議之非實質替代(insubstantial substitute)之一些其他理由<sup>134</sup>。隨後，於2003年，美國聯邦巡迴法院將本案再發回地區法院就這些要因，亦即「Festo要因(Festo factors)」<sup>135</sup>為進一步審理<sup>136</sup>。而發展一百五十年以來之均等論爭議，亦因之而暫時塵埃落定。

<sup>126</sup> Id. “The majority contends that the approach followed by our court in *Kinzenbaw v. Deere & Co.*, 741 F.2d 383, 222 USPQ 929 (Fed. Cir. 1984), is different than the flexible bar approach espoused in *Hughes* and its progeny. I disagree”.

<sup>127</sup> *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 533 U.S. 915 (2001) (“Festo VII”).

<sup>128</sup> “a narrowing amendment made to satisfy any requirement of the Patent Act may give rise to an estoppel.” *Festo VIII*, 535 U.S. at 736.

<sup>129</sup> The Court disagreed with our adoption of a complete bar to the doctrine of equivalents when prosecution history estoppel arises. See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359 (Fed. Cir. 2003) (en banc) (“Festo II”).

<sup>130</sup> Id. The Court instead established a presumption that a narrowing amendment made for a reason of patentability surrenders the entire territory between the original claim limitation and the amended claim limitation.

<sup>131</sup> Id. A patentee may overcome that presumption by showing that “at the time of the amendment one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent.”

<sup>132</sup> The equivalent [would] have been unforeseeable at the time of the [amendment]. See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 533 U.S. 915 (2001) (“Festo VII”).

<sup>133</sup> The rationale underlying the amendment [bore] no more than a tangential relation to the equivalent in question. Id.

<sup>134</sup> There [was] some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question. Id.

<sup>135</sup> Therefore, on remand for assessment of the Supreme Court’s *Festo* factors. See *Biogen, Inc. v. Berlex Labs., Inc.*, 318 F.3d 1132, 1139-40 (Fed. Cir. 2003)

<sup>136</sup> *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359 (Fed. Cir. 2003) (en banc) (“Festo II”).

## 二、禁反言

申請過程之禁反言(prosecution history estoppel)係為衡平理論(equitable doctrine)<sup>137</sup>，其可作為均等論之法律限制(legal limitation)<sup>138</sup>。

其實，專利訴訟中所涉及之禁反言，尚包括如衡平禁反言(equitable estoppel)<sup>139</sup>；出讓人之禁反言(assignor estoppel)<sup>140</sup>；被授權人之禁反言(licensee estoppel)<sup>141</sup>；審判上的禁反言(judicial estoppel)<sup>142</sup>；及附隨禁反言(collateral estoppel)<sup>143</sup>，而爭議最多者，乃阻卻均等論行使之申請過程之禁反言<sup>144</sup>。

<sup>137</sup> Prosecution history estoppel, moreover, is an equitable doctrine. See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 563 (Fed. Cir. 2000) (en banc) (“Festo VI”).

<sup>138</sup> The first legal limitation a court should consider is prosecution history estoppel, because prosecution history estoppel may completely bar the application of the doctrine of equivalents to a given claim element. Id.

<sup>139</sup> See *Forest Laboratories, Inc. v. Abbott Laboratories*, 239 F.3d 1305, 57 USPQ2d 1794 (Fed. Cir. 2001), Equitable estoppel may be imposed in a patent case when a patentee induces another party to believe that it will not sue that party for infringement.

<sup>140</sup> See *Mentor Graphics Corp. v. Quickturn Design Sys., Inc.*, 150 F.3d 1374, 1377, 47 USPQ2d 1683, 1685 (Fed. Cir. 1998). Assignor estoppel prevents a party who assigns a patent to another from later challenging the validity of the assigned patent. See *Diamond Scientific v. Ambico, Inc.*, 848 F.2d 1220, 1224, 6 USPQ2d 2028, 2030 (Fed. Cir. 1988).

<sup>141</sup> See *Flex-Foot, Inc. v. CRP, Inc.*, 238 F.3d 1362, 1365, 57 USPQ2d 1635, 1637 (Fed. Cir. 2001) Applying the doctrine of licensee estoppel, the California trial and appellate courts held that Lear was estopped from challenging the validity of the patent because it was a licensee under the patent.

<sup>142</sup> See *Interactive Gift Express, Inc. v. CompuServe Inc.*, 256 F.3d 1323, 59 USPQ2d 1401 (Fed. Cir. 2000). The doctrine provides that a party will be judicially estopped from asserting a position on appeal that is directly opposed to a position that the party successfully urged at trial.

<sup>143</sup> See *Innovad Inc. v. Microsoft Corp.*, 260 F.3d 1326, 1332, 59 USPQ2d 1676, 1680 (Fed. Cir. 2001) Under the doctrine of issue preclusion, also called collateral estoppel, a judgment on the merits in a first suit precludes relitigation in a second suit of issues actually litigated and determined in the first suit. In re *Freeman*, 30 F.3d 1459, 1465, 31 USPQ2d 1444, 1448 (Fed. Cir. 1994) (citing *Lawlor v. Nat’l Screen Serv. Corp.*, 349 U.S. 322, 326 (1955)).

<sup>144</sup> See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 569, 576, 56 USPQ2d 1865, 1872, 1878 (Fed. Cir. 2000) “Prosecution history estoppel precludes a patentee from obtaining under the doctrine of equivalents coverage of subject matter that has been relinquished during the prosecution of its patent application.” Id. at 1376, 50USPQ2d at 1036.

申請過程之禁反言理論可阻卻專利權人對申請專利過程中被拋棄之主題標的主張均等<sup>145</sup>，運用禁反言以阻卻均等論之行使之最早案例之一係為 1880 年之 Goodyear 案<sup>146</sup>，唯當時並未使用「申請過程之禁反言」字眼，但是其理論核心一直延用至今<sup>147</sup>。實則，「全卷之禁反言(file wrapper estoppel)」一詞最早是出現在 1942 年之 Exhibit Supply 案<sup>148</sup>，而「申請過程之禁反言」一詞，則是在 Warner-Jenkinson 案中才首次出現<sup>149</sup>，且為目前所有之判決所採用；而於先前之一些判決中，亦有將申請過程之禁反言類比於「復奪原則(recapture rule)」者<sup>150</sup>，因為兩者都在防止專利權人再攫取申請專利過程中為了支持專利要件而拋棄的主題標的<sup>151</sup>。

於認定是否申請人拋棄了特定之主題標的，則必需視申請過程中為了克服先前技藝之抗辯以及申請專利範圍之改變<sup>152</sup>，易言之，申請過程之禁反言包含

兩種情況，亦即(1)修正基礎下的禁反言(amendment-based estoppel)；及(2)抗辯基礎下的禁反言(argument-based estoppel)<sup>153</sup>。

## (一)修正基礎之禁反言

禁反言可經由申請專利過程中因修正而限縮申請專利範圍之範圍而引致<sup>154</sup>，亦即，限縮修正會產生禁反言之可抗辯推定(rebuttable presumption of estoppel)<sup>155</sup>，更確切的說，為了滿足專利法規要件之限縮修正會引致禁反言<sup>156</sup>，因為，專利權人限縮其申請專利範圍之決定，可被推定為原來申請專利範圍與修正後之申請專利範圍間之區域之放棄(disclaimer)<sup>157</sup>；也就是說，當專利權人原來請求被主張為侵權之主題標的，唯於申請專利過程為了回應核駁而將之限縮，則可被推定為被拋棄之疆域(territory surrendered)，而不再是所請求疆域之均等<sup>158</sup>。

從最高法院之 Festo II 案後，為了抗辯禁反言之適用，專利權人必須證明於修正當時，熟習該項技藝人士不會被合理的期待撰寫可文義上包含(literally encompassed)該主張均等之申請專利範圍<sup>159</sup>，而於最高

<sup>145</sup> This doctrine bars a patentee from asserting as an equivalent subject matter surrendered during prosecution of the patent application. *Am. Permahedge, Inc. v. Barcana, Inc.*, 105 F.3d 1441, 1445-46, 41 USPQ2d 1614, 1618 (Fed. Cir. 1997).

<sup>146</sup> See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 563 (Fed. Cir. 2000) (en banc) ("Festo VI"). One of the first cases in which the Supreme Court discussed the principles underlying our present doctrine of prosecution history estoppel is also one of the most instructive. *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 223-27 (1880)

<sup>147</sup> *Id.* Finally, although these older cases do not specifically recite either of the synonymous phrases "prosecution history estoppel" or "file wrapper estoppel," the principles articulated in these cases form the core of the doctrine of prosecution history estoppel that we have applied until today.

<sup>148</sup> *Id.* The phrase "file wrapper estoppel" was not employed by the Supreme Court until its decision in *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 128, 62 S.Ct. 513, 515 (1942).

<sup>149</sup> *Id.* and the Supreme Court did not use the phrase "prosecution history estoppel" until *Warner-Jenkinson*, 520 U.S. at 30, 117 S.Ct. at 1049. Nonetheless, the Court recognized in *Warner-Jenkinson* that many of the cases I cite below, such as *Sutter and Hubbell*, indeed set forth the principles of our present doctrine of "prosecution history estoppel." See *Warner-Jenkinson*, 520 U.S. at 30-31, 117 S.Ct. at 1049-50. I believe that the absence of the phrase "prosecution history estoppel" in the cases I cite is hardly a convincing basis for distinguishing them.

<sup>150</sup> See *Hester Indus., Inc. v. Stein, Inc.*, 142 F.3d 1472, 1479, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998). Indeed, the recapture rule is quite similar to prosecution history estoppel, which prevents the application of the doctrine of equivalents in a manner contrary to the patent "prosecution history" quoting *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 117 S. Ct. 1040, 1051 (1997).

<sup>151</sup> *Id.* Like the recapture rule, prosecution history estoppel prevents a patentee from regaining subject matter surrendered during prosecution in support of patentability.

<sup>152</sup> See *In re Clement*, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1163 (Fed. Cir. 1997). To determine whether an applicant surrendered particular subject matter, we look to the prosecution

history for *arguments* and changes to the claims made in an effort to overcome a prior art rejection

<sup>153</sup> See *Deering Precision Instruments, L.L.C. v. Vector Distribution Systems, Inc.*, 347 F.3d 1314 (Fed. Cir. 2003) There are two distinct theories that fall under the penumbra of prosecution history estoppel—amendment-based estoppel and argument-based estoppel.

<sup>154</sup> *Allen Eng' g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1349, 63 USPQ2d 1769, 1776 (Fed. Cir. 2002) An estoppel may arise as a result of amendments that narrow the scope of a claim to satisfy any requirement of the Patent Act. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S.Ct. 1831, 1839, 62 USPQ2d 1705, 1711-12 (2002).

<sup>155</sup> *Allen Eng' g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1349, 63 USPQ2d 1769, 1776 (Fed. Cir. 2002) Narrowing amendments create a rebuttable presumption of estoppel.

<sup>156</sup> *Deering Precision Instruments, LLC v. Vector Distribution Systems, Inc.*, --- F.3d ----, 2003 WL 22358859, Fed.Cir.(Oct 17, 2003). With respect to amendment-based estoppel, "a narrowing amendment made to satisfy any requirement of the Patent Act may give rise to an estoppel." *Festo II*, 535 U.S. at 733.

<sup>157</sup> *Id.* at 736. "A patentee's decision to narrow his claims . . . may be presumed to be a general disclaimer of the territory between the original claim and the amended claim." *Festo II*, 535 U.S. at 733.

<sup>158</sup> *Deering Precision Instruments, LLC v. Vector Distribution Systems, Inc.*, --- F.3d ----, 2003 WL 22358859, Fed.Cir.(Oct 17, 2003). When the patentee originally claimed the subject matter alleged to infringe but then narrowed the claim in response to a rejection, "courts may presume the amended text was composed with awareness of this rule and that the territory surrendered is not an equivalent of the territory claimed.

<sup>159</sup> *Deering Precision Instruments, LLC v. Vector Distribution Systems, Inc.*, --- F.3d ----, 2003 WL 22358859, Fed.Cir.(Oct 17,

法院之Festo III案判決後，此抗辯可經由下列三途徑之一以達成，亦即，(1)該均等為修正當時所不可預見(unforeseeable)；(2)該修正之理由無關乎(tangential relation)爭議之均等；及(3)可證明專利權人不會被合理的期待(could not reasonably expected to)於描述該爭議之非實質替代(insubstantial substitute)之一些其他理由(some other reason)<sup>160</sup>。

## (二)答辯基礎之禁反言

邏輯上說，於一些情況下，從事答辯時並不涉及申請專利範圍之修正<sup>161</sup>，但是為了克服先前技藝之答辯，亦會引致禁反言<sup>162</sup>，需注意者，當任何答辯基礎下的禁反言影響一項申請專利範圍之一限制條件時，則禁反言會延伸(extend to)至其他所有申請專利範圍項之該限制條件<sup>163</sup>；易言之，對一申請專利範圍項之用語(term)答辯以致於產生禁反言時，則該禁反言亦適用於其他所有申請專利範圍項之該用語<sup>164</sup>。

前已述及者，為了閃避先前技藝而為之限縮修正，會引致禁反言，相同地，為了克服先前技藝而為之答辯，亦同樣足以引致拋棄之認定(finding of

surrender)<sup>165</sup>，即使該答辯並不涉及修正亦然<sup>166</sup>。所以，於專利申請過程中，因涉及專利要件，以明白主張(unmistakable assertions)方式支持專利要件時，其如同修正申請專利範圍一樣，亦會引致禁反言<sup>167</sup>，其推理為，答辯本身會引致復奪原則下之拋棄，因此，亦引致了申請過程之禁反言<sup>168</sup>。事實上，於一些情況下，拋棄係僅由單純的答辯本身(argument alone)而發生<sup>169</sup>。為了訴諸於答辯基礎之禁反言，申請過程必須證明(evince)「清楚與明白的主題標的之拋棄(clear and unmistakable surrender of subject matter)」<sup>170</sup>。總而言之，於申請專利過程中為了確保(secure)申請專利範圍之核准而為之答辯，亦會引致禁反言<sup>171</sup>，因為若專利權人於修正或答辯中放棄(relinquished)潛藏申請專利範圍之解讀(potential claim construction)，以克服或區別

<sup>165</sup> Hester Indus., Inc. v. Stein, Inc., 142 F.3d 1472, 1479, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998); Arguments made to overcome prior art can equally evidence an admission sufficient to give rise to a finding of surrender.

<sup>166</sup> Hester Indus., Inc. v. Stein, Inc., 142 F.3d 1472, 1479, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998); Indeed, in Mentor and Clement the findings of a surrender were based in part on the arguments made in conjunction with the claim amendments. Mentor, 998 F.2d at 995-96, 27 USPQ2d at 1524-25; Clement, 131 F.3d at 1470-71, 45 USPQ2d at 1165-66. Logically, this is true even when the arguments are made in the absence of any claim amendment.

<sup>167</sup> Hester Indus., Inc. v. Stein, Inc., 142 F.3d 1472, 1479, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998); This court earlier concluded that prosecution history estoppel can arise by way of unmistakable assertions made to the Patent Office in support of patentability, just as it can by way of amendments to avoid prior art. See, e.g., Texas Instruments, Inc. v. International Trade Comm., 998 F.2d 1165, 1174, 26 USPQ2d 1018, 1025 (Fed. Cir. 1993).

<sup>168</sup> Hester Indus., Inc. v. Stein, Inc., 142 F.3d 1472, 1479, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998); The same reasoning that led us to conclude that arguments alone can give rise to prosecution history estoppel lends support to the proposition that arguments alone can give rise to a surrender for purposes of the recapture rule.

<sup>169</sup> Hester Indus., Inc. v. Stein, Inc., 142 F.3d 1472, 1479, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998); Thus we conclude that, in a proper case, a surrender can occur through arguments alone.

<sup>170</sup> Deering Precision Instruments, LLC v. Vector Distribution Systems, Inc., --- F.3d ---, 2003 WL 22358859, Fed.Cir.(Oct 17, 2003). "To invoke argument-based estoppel, the prosecution history must evince a 'clear and unmistakable surrender of subject matter.'" Eagle Comtronics, Inc. v. Arrow Communication Labs., Inc., 305 F.3d 1303, 1316 (Fed. Cir. 2002) (quoting Pharmacia & Upjohn Co. v. Mylan Pharms., Inc., 170 F.3d 1373, 1376-77 (Fed. Cir. 1999)).

<sup>171</sup> Allen Eng'g Corp. v. Bartell Indus., Inc., 299 F.3d 1336, 1349, 63 USPQ2d 1769, 1776 (Fed. Cir. 2002) An estoppel also may be found on the basis of argument made during prosecution of the application to secure the allowance of claims. also See Elkay Mfg. Co. v. Ebco Mfg. Co., 192 F.3d 973, 979, 52 USPQ2d 1109, 1113 (Fed. Cir. 1999)

2003). In those instances, however, the patentee must show that at the time of the amendment one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent."

<sup>160</sup> Deering Precision Instruments, LLC v. Vector Distribution Systems, Inc., --- F.3d ---, 2003 WL 22358859, Fed.Cir.(Oct 17, 2003). This can be shown by one of the following three criteria: (1) the equivalent may have been unforeseeable at the time of the amendment; (2) the rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question; or (3) there may be some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question. Festo III, \_\_\_ F.3d at

<sup>161</sup> See Hester Indus., Inc. v. Stein, Inc., 142 F.3d 1472, 1479, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998) Logically, this is true even when the arguments are made in the absence of any claim amendment. Amendment of a claim is not the only permissible predicate for establishing a surrender.

<sup>162</sup> Id. Arguments made to overcome prior art can equally evidence an admission sufficient to give rise to a finding of surrender. Indeed, in Mentor and Clement the findings of a surrender were based in part on the arguments made in conjunction with the claim amendments. Mentor, 998 F.2d at 995-96, 27 USPQ2d at 1524-25; Clement, 131 F.3d at 1470-71, 45 USPQ2d at 1165-66.

<sup>163</sup> Any argument-based estoppel affecting a limitation in one claim extends to all claims in which that limitation appears. See Eagle Comtronics v. Arrow, 2002.

<sup>164</sup> See Southwall Techs., Inc. v. Cardinal IG Co., 54 F.3d 1570, 1583, 34 USPQ2d 1673, 1682 (Fed. Cir. 1995) Once an argument is made regarding a claim term so as to create an estoppel, the estoppel will apply to that term in other claims.

(overcome or distinguish)於引證資料(reference)時，申請專利範圍之範疇會有所改變(change)<sup>172</sup>。

至於有關禁反言之範圍，先前判決中認為，申請過程之禁反言之範疇(scope of prosecution history estoppel)，可能從很大以至於小到零之限制效應(limiting effect)，且此效應也許可能或不能致命性的寬廣適用至包含一特定被控產品(particular accused product)之均等範疇<sup>173</sup>，而專利權人於申請過程中所拋棄之主題標的為何，應由專利權人之合理競爭者之有利點(vantage point of reasonable competitor)以衡量<sup>174</sup>，且應該參酌先前技藝及專利權人意圖區別(attempt to distinguish)該技藝之修正或答辯而為認定<sup>175</sup>。而於Warner-Jenkinson案<sup>176</sup>後，禁反言之範疇視修正而為合理的推論(inference)<sup>177</sup>，亦即，專利權人並不被阻卻主張均等至修正當時為不可預見(unforeseeable)且合理解讀(fair interpretation)為拋棄之外，或無關乎修正理由者<sup>178</sup>。當然，專利權人對證明該修正並未拋棄該爭議之

<sup>172</sup> See *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 973, 979, 52 USPQ2d 1109, 1113 (Fed. Cir. 1999) (holding that the scope of coverage of the claims may change if a patentee has “relinquished [a] potential claim construction in an amendment to the claim or in an argument to overcome or distinguish a reference”); *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1583, 34 USPQ2d 1673, 1683 (Fed. Cir. 1995).

<sup>173</sup> *Sextant Avionique, S.A. v. Analog Devices, Inc.*, 172 F.3d 817, 831, 49 USPQ2d 1865, 1874-75 (Fed. Cir. 1999) Our case law recognizes that the scope of prosecution history estoppel “may have a limiting effect within a spectrum ranging from great to small to zero. The effect may or may not be fatal to application of a range of equivalents broad enough to encompass a particular accused product.” *Hughes Aircraft Co. v. United States*, 717 F.2d 1351, 1363, 219 USPQ 473, 481 (Fed. Cir. 1983).

<sup>174</sup> The scope of estoppel, i.e., what subject matter has been surrendered during prosecution by the patentee, is to be viewed from the vantage point of a reasonable competitor of the patentee, see *Haynes Int'l v. Jessop Steel Co.*, 8 F.3d 1573, 1578, 28 USPQ2d 1652, 1656 (Fed. Cir. 1993)

<sup>175</sup> *Sextant Avionique, S.A. v. Analog Devices, Inc.*, 172 F.3d 817, 831, 49 USPQ2d 1865, 1874-75 (Fed. Cir. 1999) and is determined with reference to the prior art and any amendments and/or arguments made in an attempt to distinguish such art, see *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 72 F.3d 857, 864, 37 USPQ2d 1161, 1165 (Fed. Cir. 1995), vacated on other grounds, 117 S. Ct. 1240 (1997).

<sup>176</sup> *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 33, 41 USPQ2d 1865, 1873 (1997).

<sup>177</sup> *Allen Eng' g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1349, 63 USPQ2d 1769, 1776 (Fed. Cir. 2002) The scope of the estoppel depends on “the inferences that may reasonably be drawn from the amendment.” *Id.* at 1840, 62 USPQ2d at 1712.

<sup>178</sup> *Allen Eng' g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1349, 63 USPQ2d 1769, 1776 (Fed. Cir. 2002) A patentee is not barred from asserting “equivalents unforeseeable at the time of the amendment and beyond a fair interpretation of what was surrendered,” or those that “have only a peripheral relation

均等負舉證責任<sup>179</sup>，且均等論或禁反言之探究，必須在逐一元件基礎(element-by-element basis)下為之<sup>180</sup>，並可作為侵權防禦(defense to infringement)<sup>181</sup>

## 肆、限制條件之權利態樣

於專利侵害或專利無效之訴訟中，首先必須對系爭專利之申請專利範圍予以解讀<sup>182</sup>，由於申請專利範圍之撰寫，申請專利過程對申請專利範圍所作的變動，因此，申請專利範圍之個別元件或限制條件之對待會有所不同，茲將其可能之態樣分述如下：

### 一、揭示唯未請求者

對於列述說明書中唯未被請求於申請專利範圍之限制條件，係適用「揭示-貢獻原則」，亦即，不得藉均等論復奪列述於說明書中唯未被請求之各該限制條件<sup>183</sup>，或許可藉由以下實例以說明<sup>184</sup>：

#### (一)系爭專利

系爭專利係為美國第 6, 061, 239 號之電子積體電路，如微晶片之散熱握持夾。其發明說明書中述及：「其他使用模具成型及/或金屬零件之前技藝裝置必須被鑄造或鍛造，其再次地為較昂貴之金屬成型操作」。此外，發明說明中亦述及：「該帶體可被如不

to the reason the amendment was submitted.” *Id.* at 1841, 62 USPQ2d at 1712

<sup>179</sup> *Allen Eng' g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1349, 63 USPQ2d 1769, 1776 (Fed. Cir. 2002) The patentee bears the burden of overcoming the presumption by “showing that the amendment does not surrender the particular equivalent in question.” *Id.* at 1842, 62 USPQ2d at 1713.

<sup>180</sup> *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 569, 576, 56 USPQ2d 1865, 1872, 1878 (Fed. Cir. 2000) the Court stated that it chose to “adhere to the doctrine of equivalents,” which “should be applied as an objective inquiry on an element-by-element basis.”

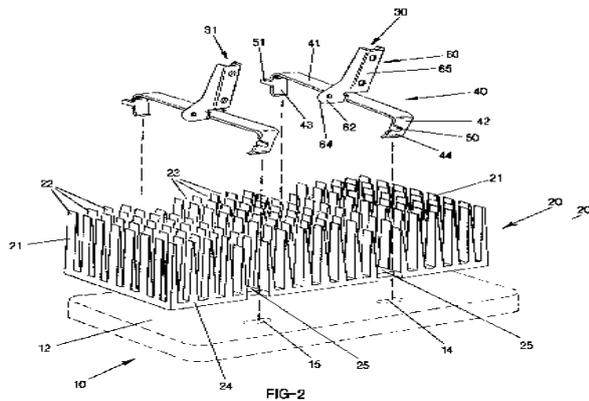
<sup>181</sup> *Warner-Jenkinson*, 520 U.S. at 29. The Court noted that “[p]rosecution history estoppel continues to be available as a defense to infringement.”

<sup>182</sup> An infringement analysis involves two steps. First, the court determines the scope and meaning of the patent claims asserted, See *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1456, 46 USPQ2d 1169, 1174 (Fed. Cir. 1998) (en banc).

<sup>183</sup> The disclosure-dedication rule requires an inventor who discloses specific matter to claim it, and to submit the broader claim for examination. Otherwise, that matter is dedicated to the public and may not be recaptured under the doctrine of equivalents. See, e.g., *PSC Computer Prods., Inc. v. Foxconn Int' l, Inc.*, 355 F.3d 1353, 1356-57 (Fed. Cir. 2004).

<sup>184</sup> *Id.*

銹鋼帶撓性金屬製成，雖然其他撓性材料亦可被用於帶體...」。



一、一凹槽；此改良包含一散熱夾具，其包括：  
一延伸，軟質金屬帶體被收納於散熱器之一凹槽，其每端具有握持裝置干涉於模組上之嚙合裝置，該帶之中央部份於未拉緊狀態於散熱器之上表面上具一預設之距離；  
一凸輪式之門件樞接嵌置於帶體之中央部份，且包括一具一軸承表面之凸輪，當帶體拉緊時，由樞軸至入口至凸輪之軸承表面距離大於樞軸入口及散熱器座之上表面之距離，且具一支臂固定嵌設於所述凸輪，當轉動時，所述支臂引致所述凸輪之所述軸承表面向散熱器座之表面施壓使帶體拉緊，以致於迫使散熱器進入熱傳導之模組。

<sup>185</sup> In a heat sink assembly providing cooling to an electronic semiconductor device wherein the device is mounted in a module, the module having means for engagement with a retainer clip, and the heat sink having a generally flat bottom surface and heat conducting engagement with the semiconductor device upper surface and a plurality of fins on the upper surface defining at least one channel, the improvement comprising a heat sink retainer clip including:

an elongated, resilient metal strap received in one of the channels of the heat sink having holding means at each end engaging the engagement means on the module, the center portion of the strap spaced a pre-determined distance above the upper surface of the heat sink base when the strap is not in tension; and

a cam-type latch pivotally mounted in the center portion of the strap and including a cam with a bearing surface, the distance from the pivot access to the bearing surface of the cam being greater than the distance between the pivot access and the upper surface of the base of the heat sink when said strap is not in tension, and an arm fixedly mounted to said cam, said arm, when rotated, causing said bearing surface of said cam to be forced against the surface of the base of the heat sink placing the strap in tension so as to force the heat sink into heat conducting engagement with the module.

### (三)被控物品

被控物品其係相同於系爭專利之構造，唯由塑膠材料製成。

### (四)判決結果

本案經加州中區法院判決認為申請專利範圍只列述金屬帶體，因此，對於發明說明書中所提及而未請求之如塑膠材料視為不請求，並屬貢獻給公眾。

經由上訴至美國聯邦巡迴法院後，引用了自 1880 年 Burns 案判決所稱且一路沿用之觀點，亦即「專利之申請專利範圍限制發明，而說明書不能被用以擴張專利獨占 (expand the patent monopoly)」<sup>186</sup>，因而將該帶體限制在金屬上，不得以均等主張至塑膠材料帶體。

同時，本案首次定義這種不請求態樣係為「揭示一貢獻原則」，而於 2004 年 9 月之 Toro Co. 案中，則再次引用此原則，並稱：「揭示一貢獻原則限制均等論之適用，正如同申請過程之禁反言一般」<sup>187</sup>，而且定義為「法律問題 (matter of law)」。

## 二、抗辯而拋棄

於申請專利過程中，為了閃避先前技藝而為之抗辯，若該抗辯特別定義該限制條件，則不管是否修正該項申請專利範圍，所有申請專利範圍一體適用，易言之，即使只修正一些申請專利範圍項，唯未修正之申請專利範圍項之該限制條件或用語亦應為相同之解讀<sup>188</sup>。此或許可由下列案例以為進一步說明<sup>189</sup>。

<sup>186</sup> The relationship between a patent's claim and its written description has also long been understood:

While the claims of a patent limit the invention, and specifications cannot be utilized to expand the patent monopoly, *Burns v. Meyer*, 100 U.S. 671, 672 (1880); *McCarty v. Lehigh Valley R. Co.*, 160 U.S. 110, 116 (1895),

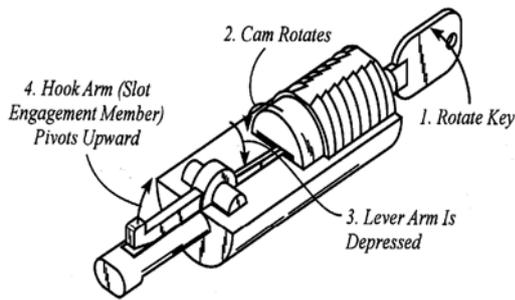
<sup>187</sup> The disclosure-dedication rule limits application of the doctrine of equivalents, much in the same way as prosecution history estoppel.

<sup>188</sup> Statements made during prosecution which clearly disclaim a particular claim interpretation will limit the scope of the claims. *Ballard Medical Products v. Allegiance Healthcare Corp.*, 268 F.3d 1352, 1359, 60 USPQ2d 1493, 1498 (Fed. Cir. 2001). See *Southwall Technologies, Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576, 34 USPQ2d 1673, 1676 (Fed. Cir. 1995) ("The prosecution history limits the interpretation of claim terms so as to exclude any interpretation that was disclaimed during prosecution.")

<sup>189</sup> *ACCO BRANDS, INC. v. MICRO SECURITY DEVICES, INC.*

## (一)系爭專利

系爭專利係為美國第 5,502,989 號專利，該專利係為一可攜式電子裝置之上鎖機制。且其係美國專利申請案號第 07/824,964 號之分割案，且係經由再審查而取得之專利。



## (二)申請專利範圍

用以控告侵權者係為申請專利範圍第 10 頁，其列述為：

10. 一上鎖系統(locking system)，其包括：

一包含界定一安全溝槽(security slot)之外壁之可攜式電子裝置；

用以連結於異於可攜式電子裝置之第一標的之纜線裝置(cable means)；

一殼體，緊鄰(proximate)於所述電子裝置，且包含一溝槽干涉構件(slot engagement member)，其具有溝槽干涉部位並設以上鎖構件(locking member)，該上鎖構件具有一周邊尺寸互補於所述安全溝槽之預設尺寸，藉之可使所述上鎖構件延伸進入該溝槽，所述溝槽干涉構件被於所述上鎖構件於溝槽中運動之非上鎖位置(unlocked position)，以及所述上鎖構件被保持於溝槽內之上鎖位置(locked position)之間轉動；

一梢(pin)，耦合地穿越所述殼體，用以於所述之溝槽干涉構件於所述上鎖位置時延伸進入所述緊鄰於所述溝槽干涉部位，藉之防止所述溝槽干涉構件轉動至所述非上鎖位置；及

耦合至所述殼體，用以連結所述纜線至所述殼體之裝置<sup>190</sup>。

<sup>190</sup> A locking system, comprising:

## (三)被控裝置

被控裝置基本上係為上鎖機制，尤其圖式得知，唯對應於系爭專利之梢之「凸環結構(flanged tab structure)」，係於對應於系爭專利之「溝槽干涉元件」，且「鉤臂(hook arm)」進入上鎖位置前，延伸進入鉤槽。

## (四)申請專利過程

系爭專利之原始提交之申請專利範圍第 1、10 及 11 項均具有「於所述上鎖位置時延伸進入所述緊桿於所述溝槽干涉部位」限制條件。

於再審查時，為了回應顯而易知性之引證核駁時，專利權人答辯稱：「當所述溝槽干涉構件於所述上鎖位置」為引證資料所無，並稱：「因為 Young 案(引證案)失之於教示於溝槽干涉構件於上鎖位置後，延伸進入安全溝槽之梢」，同時，亦修正申請專利範圍第 1 項，將「用以延伸..(for extending into)」修正為「及延伸之後(and extending after)」。

而後審查委員於核准理由中述及：「特別是先前技藝失之於使一具有被置入一電腦，其具有對應於該上鎖構件之開口內之後可轉動至上鎖位置之上鎖構件，及接著一梢於上鎖構件被轉至上鎖位置而被置入於開口，以保持上鎖裝置於電腦內，以至於電腦可經由纜線上鎖於另一標的，以防止電腦失竊為顯而易知之教示」，專利權人對此並未回應。

## (五)判決結果

本案經加州北區地區法院判決認為系爭專利之申請專利範圍第 10 項並不及於溝槽干涉構件被轉至

a portable electronic device including an exterior wall defining a security slot;  
 cable means for attaching to a first object other than to the portable electronic device;  
 a housing, proximate to said electronic device and including a slot engagement member having a slot engaging portion provided with a locking member having a peripheral profile complementary to preselected dimensions of said security slot to thereby permit said locking member to extend into said slot, said slot engagement member being rotatable between an unlocked position wherein said locking member is removable from the slot, and a locked position wherein said locking member is retained within the slot;  
 a pin, coupled through said housing, for extending into said security slot proximate said slot engaging portion when said slot engagement member is in said locked position to thereby inhibit rotation of said slot engagement member to said unlocked position; and  
 means, coupled to said housing, for attaching said cable to said housing.

上鎖位置之前，稍延伸進入保全溝槽之解讀，因此不涉侵權。

而美國聯邦巡迴上訴法院則認為申請專利範圍第 10 項雖然未修正，但是該限制條件亦應相同於申請專利範圍第 1 項之解讀，亦即此發明應被理解為稍於轉動後延伸進入溝槽，亦即，申請專利過程中限制申請專利範圍用語之解讀，以致於排除於申請專利過程中拋棄之任何解讀，而申請專利過程中所為之明白拋棄一特定請求之解讀之陳述(如延伸進入之前)，將限制申請專利範圍之範疇，因此，被告不涉侵權。

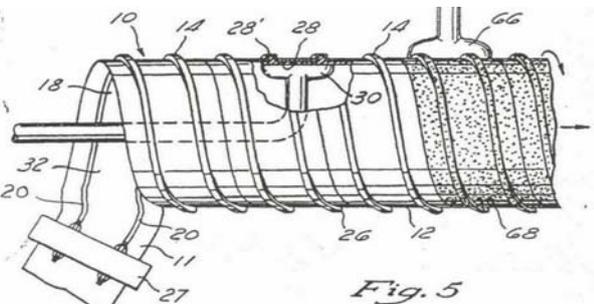
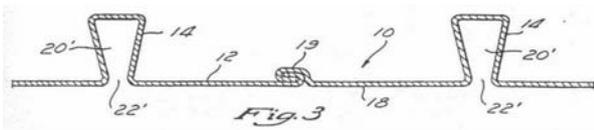
本案若未加以參酌申請專利過程，則可能會因「請求項差異理論(doctrine of claim differentiation)」而認為系爭專利之申請專利範圍第 10 項之該限制條件可不同於申請專利範圍第 1 項解讀<sup>191</sup>。

### 三、修正而限定

所謂修正而限定係為，於申請專利過程中，為了閃避先前技藝而修正申請專利範圍，且內部證據顯示其抗辯記錄，則此時該專利所請求之該修正元件，係被限定在該特定意涵<sup>192</sup>，或許可藉以下例子說明。<sup>193</sup>

#### (一)系爭專利

系爭專利係為美國第 4, 838, 317 號專利，該專利係為一種纏繞式水管，其代表圖式如下所示：



and the right of patentees to seek broad patent coverage, we have thus consistently rejected prosecution statements too vague or ambiguous to qualify as a disavowal of claim scope.”)

<sup>193</sup> W.E. HALL COMPANY, INC., v. ATLANTA CORRUGATING, LLC,

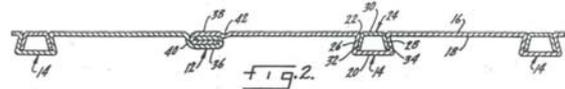
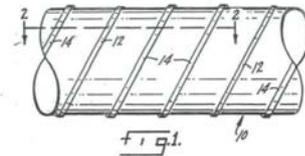
#### (二)申請專利過程

於審查階段時，審查委員引證美國第 9, 161, 194 號專利(Nyssen)專利，該專利之圖式如下：

#### (三)申請專利範圍之修正與限定

為了閃避此先前技藝，專利權人認為其申請案與引證之 Nyssen 前案不同處，在於其無需於肋條之凹槽內加置嵌件(inserts)，而僅以單一構成即可。

審查委員則要求申請專利範圍必須由「單一構成(of unitary construction)」改成單片結構(of single piece



construction)，且連接詞用語應由「包括(comprising)」改成「必然由以組成(consisting essentially of)」，因此，修正並核准之申請專利範圍如下<sup>194</sup>：

1.用於埋設為排水管之單片結構之水力效率地下管件，所述管件本質上之組成為：

一具有厚度 8-12 guage 及界定出管徑為 24-120 英寸範疇之間之圓筒形金屬壁；

<sup>194</sup> A hydraulically efficient underground pipe of single piece construction for use in buried storm drains, said pipe consisting essentially of a cylindrical metal wall having an 18-12 gauge thickness and defining a pipe diameter within the range of 24-120 inches, a rigid lock seam extending helically about and along the length of said wall and a plurality of outwardly projecting walled-structural supporting ribs extending helically about and along the length of said wall and being integrally formed therewith, said ribs defining a corresponding plurality of open channels formed interiorly thereof, the width and depth of said open channels being within the range of 0.5 to 1.5 inches and the spacing between said ribs being within the range of 6-12 inches to render the pipe substantially rigid and possess sufficient structural strength to withstand the stresses of being buried underground. eans to increase the hydraulic efficiency of fluid flowing through the pipe consisting of substantial portions of said wall extending between said open channels being of constant radius, and said lock seam being disposed in said portions of constant radius to provide a substantially uninterrupted smooth flow.

沿著所述之壁螺旋狀延伸之剛硬之鎖皺(lock seam)；及若干外突之壁結構上之支撐肋條，其沿著所述之壁呈螺旋狀延伸並與其一體成型；

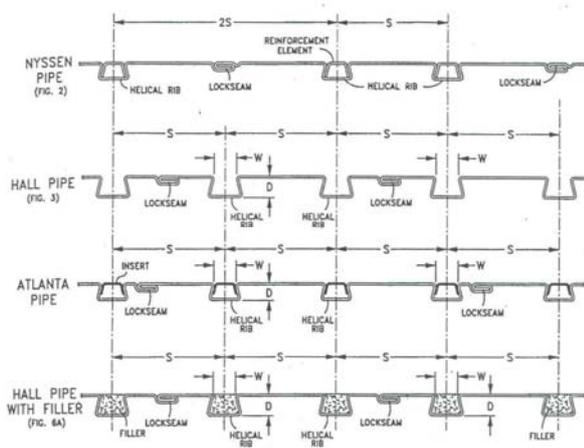
所述肋條界定一對應之若干自其內部形成之開放槽；所述開放槽之寬度與深度係介於 0.5 至 1.5 英寸之間，且肋條間之間距係為介於 6 至 12 英寸之間，以使管件實質上剛硬及擁有足夠之結構應力，以於埋入地下時經得起應力；

提高流體流經管件時之水力效率之手段，其由所述壁於開放槽之間延伸之實質部位係為不變的半徑，且所述鎖皺被設於所述不變的半徑部位，以提供實質連續的順暢流通。

#### (四)被控物品

被告 Atlanta 之產品基本上亦為可捲繞成型之水管，且其具有肋條，肋條內則加置嵌件，事實上，其較近似於前述之美國 Nyssen 專利所述者。

Hall 專利，Nyssen 先前技藝，以及 Atlanta 之被控產品之圖式並列如下：



#### (五)判決結果

由地區法院以至於聯邦巡迴上訴法院都一致認為，申請人對於申請專利範圍用語，並無自行編纂，故應以通常與慣常之意涵解讀，而於審查內部證據後發現，專利權人為了說服審查委員以閃避先前 Nyssen 案之引證時述及，其排除開放槽內置放強化元件

(reinforcing elements)之設計，不會是顯而易知於熟習該項技藝人士，且辯稱：「附加強化元件之使用必然增加於材料之步驟之構造成本」，且「Nyssen 之兩件式結構，係為市場失敗之原因」等，因而取得專利，因此，其權利不得涵蓋至槽內具有強化元件之產品，因此，判決不涉侵權。

本案例乍看之下會認為很有可能侵權，唯當參酌內部證據後則會得到截然不同之結論<sup>195</sup>。

#### 四、限縮修正

所謂限縮修正乃是原申請專利範圍中未限定範圍或是較大範圍，唯於申請過程中為了閃避先前技藝之引證而限縮請求之範疇，這種情形則適用於Festo要因<sup>196</sup>，或許可由以下案例以說明。<sup>197</sup>

#### (一)原申請專利範圍

系爭專利係為Talbert Fuel Systems Patent Co.所有之美國第 5, 015, 356 號專利，該專利係涉及一低雷式蒸汽壓之內燃機汽油，其核准並據以控告Unocal Corp.公司侵權之申請專利範圍列述為<sup>198</sup>：

<sup>195</sup> See *Schwing GmbH v. Putzmeister Aktiengesellschaft & Putzmeister*, 305 F.3d 1318, 1324 (Fed. Cir. 2002) (“Although prosecution history can be a useful tool for interpreting claim terms, it cannot be used to limit the scope of a claim unless the applicants took a position before the PTO that would lead a competitor to believe that the applicants had disavowed coverage of the relevant subject matter.”).

<sup>196</sup> See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359 (Fed. Cir. 2003) (en banc) (“Festo II”), The Court instead established a presumption that a narrowing amendment made for a reason of patentability surrenders the entire territory between the original claim limitation and the amended claim limitation, and explained that a patentee may overcome that presumption by showing that “at the time of the amendment one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent.” *Id.* at 741. Specifically, the Court enumerated the three ways in which the patentee may overcome the presumption — i.e., by demonstrating that “the equivalent [would] have been unforeseeable at the time of the [amendment],” [2] that “the rationale underlying the amendment [bore] no more than a tangential relation to the equivalent in question,” or that “there [was] some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question.”

<sup>197</sup> *TALBERT FUEL SYSTEMS PATENTS CO., v. UNOCAL CORPORATION, UNION OIL COMPANY OF CALIFORNIA*,

<sup>198</sup> 1. A gasoline fuel comprising hydrocarbons having an intermediate carbon range relative to gasoline which has a carbon range of C<sub>4</sub>-C<sub>12</sub>; said intermediate range being defined as

一種汽油燃料，其包含之碳氫化合物之中間產物具有與汽油相近之含碳數 4-12；該中間產物之含碳數範圍為，此中間產物範圍被界定為當 C<sub>4</sub>-C<sub>12</sub> 含碳數之汽油，因較輕之可揮發成分逐漸揮發且爆炸位能減少，而較重之成分仍以有效的含量存在於汽油中，使可維持燃燒速率仍類似於 C<sub>4</sub>-C<sub>12</sub> 之汽油時之比例。

## (二)申請專利過程

於審查時，審查委員引證了先前技藝，Hamilton 案，該案揭示了碳氫化合物之含碳數為 C<sub>5</sub>-C<sub>10</sub>，高沸點為 80°F 而至高沸點 390°F-420°F。

Talbert 辯稱該先前技藝之高沸點為 390°F，係反向教示(teach away)於其發明，因此，在審查委員堅持下，將申請專利範圍修正如下<sup>199</sup>：

一使用於標準汽化內燃引擎，並具有低雷氏蒸汽壓之液態燃油；該燃油包含一起始物質、及一碳氫化合物，且其中間產物相近於含碳數 4-12 之燃料；該中間產物含碳數必須為 6-10，並包含 C<sub>5</sub> 及 C<sub>10</sub> 兩鏈烷烴於所述之混和物中；該燃油應在一大氣壓之下，具有華氏 121-345 度之沸點……。

亦即，其加上了原申請專利範圍不受限之「具有華氏 121-345 度之沸點..」

## (三)被控物品

被告 Unocal 之燃料係具有介於 373.8°F 至 472.9°F 之沸點。

## (四)判決結果

聯邦巡迴法院認為，原告之高沸點，亦即 345°F 與引證案，亦即 Hamilton 案之高沸點範疇 390°F-420°F

the portion remaining when C<sub>4</sub>-C<sub>12</sub> gasoline has removed therefrom an effective amount of lower weight volatile components to substantially eliminate evaporative loss and explosion potential and an effective amount of higher weight to raise the burn rate of the remaining hydrocarbons to a level comparable to C<sub>4</sub>-C<sub>12</sub> gasoline.

<sup>199</sup> 1. A low Reid Vapor Pressure liquid gasoline for use in a standard carbureted internal combustion engine; said gasoline comprising a priming agent and a hydrocarbon mixture having an intermediate carbon range relative to C<sub>4</sub>-C<sub>12</sub> fuel; said intermediate carbon range consisting essentially of C<sub>6</sub>-C<sub>10</sub> hydrocarbons with C<sub>5</sub> and C<sub>10</sub> paraffinic hydrocarbons being present in the mixture; said gasoline having a boiling point range of 121°F-345°F at 1 atmosphere pressure ...

之間之範疇，係可被推定為因修正而拋棄，因此，若欲主張均等時，必須經由原告證明，當初將沸點修正為 121°F-345°F 時，對於 345°F 至 390°F 之間之溫度範圍係為不可預見，或經由其他另兩要因以證明。

然而，當先前技藝包含了被主張之均等時，通常對閃避該均等之限縮修正之主題標的，不能被認定為修正當時為不可預見<sup>200</sup>，因此，在原告無法對另兩要因為抗辯下，阻卻該均等之主張。

此外，聯邦巡迴法院亦尋求均等論之古典原則，認為亦排除該均等主張，除非該請求之發明與被主張之均等間為「非實質不同」<sup>201</sup>，認為被告之沸點與系爭專利之沸點並非幾度之差而已，因此，不可能為均等，且亦不能復奪業已拋棄者。

所以，由本案之判決可知，當年喧騰一時之 Hilton-Davis 案，若以目前之情形觀之，則可隨負立判。

## (五)獨立項放棄，將附屬項改寫為獨立項

這種情形於申請美國專利時常會發生，亦即獨立項之請求範圍過廣時，審查委員常常會建議將獨立項取消(cancel)，並將其中至少一附屬項改寫(rewrite)為獨立項形式，於國內，吾人習稱為「併項」，亦即將至少一附屬項併入獨立項中<sup>202</sup>，或許我們可藉 Ranbaxy 案作一說明<sup>203</sup>。

<sup>200</sup> When the prior art embraces the alleged equivalent, and a narrowing amendment was made to avoid that equivalent, that subject matter cannot be found to have been unforeseeable at the time of the amendment. Pioneer Magnetics, Inc. v. Micro Linear Corp., 330 F.3d 1352, 1357, 66 USPQ2d 1859, 1862 (Fed. Cir. 2003).

<sup>201</sup> In addition, the classical principles of the doctrine of equivalents preclude a finding of equivalency, for such finding requires only insubstantial differences between the invention as claimed and the alleged equivalent. See Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 39-40, 41 USPQ2d 1865, 1875 (1997); Eagle Comtronics v. Arrow Communication Labs., Inc., 305 F.3d 1303, 1315, 64 USPQ2d 1481, 1488 (Fed. Cir. 2002) ("An element in the accused product is equivalent to a claim limitation if the differences between the two are 'insubstantial' to one of ordinary skill in the art.").

<sup>202</sup> See Ranbaxy Pharmaceuticals, Inc. v. Apotex, Inc., 350 F.3d 1235 (Fed. Cir. 2003), In Festo Corp. v. Shokestu Kinsoku Kogyo Kabushiki Co., Festo argued that "[t]he PTO might require the applicant to clarify an ambiguous term, to improve the translation of a foreign word, or to rewrite a dependent claim as an independent one ....

<sup>203</sup> Id.

## (a)系爭專利之原申請專利範圍

系爭專利係為Apotex, Inc所擁有之美國第 5, 847, 118 號專利, 該專利係為治療扁桃腺炎、皮膚感染等之藥物, 其原始提交之申請專利範圍列述為<sup>204</sup>:

1. 備製非晶質之 cefuroxime axetil 之方法, 其包括, 以下步驟:
  - a. 將 cefuroxime axetil 之結晶溶解於一高極性有機溶劑, 續將所得溶液加入水中; 或
  - b. 將 cefuroxime axetil 之結晶溶解於一高極性有機溶劑, 並於混和後之所得溶液中加水, 隨後將所得之含水之有機溶液加入水中。
2. 如申請專利範圍第 1 項所述之步驟, 其中用於溶解 cefuroxime axetil 之溶劑為含有只對 cefuroxime axetil 具可溶性之溶劑。
3. 如申請專利範圍第 1、2 項所述之步驟, 其中之高極性有機溶劑係為亞砒。
4. 如申請專利範圍第 1、2 項所述之步驟, 其中之高極性有機溶劑係為二甲基亞砒。
5. 如申請專利範圍第 1、2 項所述之步驟, 其中之高極性有機溶劑係為醯胺。
6. 如申請專利範圍第 5 項所述之步驟, 其所稱之醯胺係選自二甲基甲醯胺、二甲基乙醯胺、或六甲基磷酸胺。

<sup>204</sup> 1.Process of preparation of amorphous cefuroxime axetil which comprises the steps of:

(a)dissolving crystalline cefuroxime axetil in a highly polar organic solvent and adding the resulting solution to water; or

(b)dissolving crystalline cefuroxime axetil in a highly polar solvent, adding water to the resulting solution and subsequently adding the resulting aqueous-organic solution to water.

2.The process of claim 1 wherein the dissolution of crystalline cefuroxime axetil is carried out in a volume of solvent only sufficient to dissolve crystalline cefuroxime axetil.

3.The process of claim 1 or 2 wherein the highly polar solvent is a sulfoxide.

4.The process of claim 1 or 2 wherein the highly polar solvent is dimethyl sulfoxide.

5.The process of claim 1 or 2 wherein the highly polar solvent is an amide.

6.The process of claim 5 wherein the amide is selected from the consisting of dimethyl formamide, dimethyl acetamide, or hexamethyl phosphoramide.

7.The process of claim 1 or 2 wherein the solvent is formic acid.

8.The process of claim 1 or 2 wherein the solvent is a homogenous mixture of dimethyl sulfoxide and the amide.

9.The process of claim 1 or 2 wherein the addition of the resulting solution to water is carried out between 0 to 40°C.

10.The process of claim 9 wherein the addition is carried out between 0 to 4°C.

7. 如申請專利範圍第 1、2 項所述之步驟, 其中之高極性有機溶劑係為甲酸。
8. 如申請專利範圍第 1、2 項所述之步驟, 其中之高極性有機溶劑係為均勻混和之二甲基亞砒及醯胺。
9. 如申請專利範圍第 1、2 項所述之步驟, 其中, 將所得溶液加入水中時, 作用之溫度介於攝氏 0 - 40 度。
10. 如申請專利範圍第 9 項所述之步驟, 其中添加時之溫度介於攝氏 0 - 4 度。

## (b)申請專利過程

提交專利申請後, 在先行修正(preliminary amendment)中, 將申請專利範圍修正於只依附於申請專利範圍第 1 項。

於審查時, 審查委員認為「高極性有機溶劑(highly polar organic solvent)」一詞不明確, 因此, 申請專利範圍第 1、8、10 項於美國專利法 102 條第 2 項下核駁, 並引證了美國第 5, 013, 833 號專利(833 專利), 認為申請專利範圍第 1、2、9 及 10 項在在該先前技藝下為顯而易知, 而為美國專利法第 103 條下核駁, 審查委員認為 8033 專利所揭示者, 基本上係與系爭專利申請案相同之方法。

## (c)核准之申請專利範圍

Apotex於是修正申請專利範圍, 將原申請專利範圍 1 至 10 項全數取消, 並檢附申請專利範圍修正本第 11-16 項, 其中, 申請專利範圍第 11 項係為獨立項, 於核准後, 重編為申請專利範圍第 1 項, 其列述為<sup>205</sup>:

11. 備製非晶質之 cefuroxime axetil 之方法, 其包括以下步驟:

<sup>205</sup> Process of preparation of amorphous cefuroxime axetil which comprises the steps of:

(a)dissolving crystalline cefuroxime axetil in a volume of a highly polar organic solvent only sufficient to dissolve it, and adding the resulting solution to water; or

(b)dissolving crystalline cefuroxime axetil in a volume of highly polar organic solvent, only sufficient to dissolve it, adding water to the resulting solution and subsequently adding the resulting aqueous-organic solution to water,

wherein the highly polar organic solvent is selected from the group consisting of a sulfoxide, an amide and formic acid.

- a. 將 cefuroxime axetil 之結晶溶解於一高極性有機溶劑，續將所得溶液加入水中；或
- b. 將 cefuroxime axetil 之結晶溶解於一高極性有機溶劑，並於混和後之所得之溶液中加水，隨後將該含水有機溶劑加入水中；

而其中所述之高極性有機溶劑可選自包含亞砷、醯胺、與甲酸組群者。

亦即其將原第 3、5、7 項附屬項併入原獨立項而成爲修正後的獨立項。

## (d)被控產品

被控產品係爲 Ranbaxy Pharmaceuticals, Inc. 所生產，其使用醋酸而非系爭專利所特定之任何溶劑。

## (e)法院判決

美國聯邦巡迴法院認爲，這種將獨立項取消而將特定附屬項改寫爲獨立項形式，係爲限縮修正，因此，基本上，被推定原獨立項與修正後獨立項間之範疇，係爲拋棄，亦即，除了亞砷、醯胺、甲酸外所有高極性溶劑，於修正時業已爲拋棄<sup>206</sup>。

若 Apotex 欲主張均等，則必須證明於其修正當時，醋酸係不可預見，以克服此拋棄推定，唯事實顯示，草酸與醋酸對一般熟習化學技藝人士而言，係爲相同屬性之同系物(homogenous)，因此，不可能不可預見，所以，Apotex 不能藉由均等主張至醋酸<sup>207</sup>。

## 伍、結論

進來衡平者，必須帶著乾淨的手<sup>208</sup>，由以上案例可知，專利權人於說明書以及申請過程中所爲之任何

陳述，都會影響到申請專利範圍之權利範疇，尤其是申請專利範圍具有告知社會大眾之功能，因此，在申請專利範圍之解讀上，如何求取精確與合宜，值得吾人努力。

於 Festo 過後，限縮修正後之元件，欲主張均等憂其難，而且，勢必增加訴訟成本，因此，亦有不乏撰文提出因應之道者。基本上，於申請專利過程中，應儘量避免牽一髮動全身，亦即以抗辯，如對該引證之單一限制條件抗辯其間之差異，以代替修正；<sup>209</sup> 亦有美國律師建議以電話爲口頭晤談而不將之列入記錄者；<sup>210</sup> 當然，亦有建議儘量使用手段加功能寫法，以避免修正申請專利範圍者；<sup>211</sup> 更有建議多寫幾項獨立項，且避免以「總屬(Generic, 或稱上位)」撰寫者<sup>212</sup>，不一而足。

筆者於 2002 年即與美國律師探討 Festo 效應，當時筆者預測修正後元件均等之適用會大受限制，亦即門檻更高<sup>213</sup>，其理由爲，在申請之專利範圍之限制條件欲主張均等之同時，先前引證之該習知元件又何嘗不具有均等<sup>214</sup>，相信美國最高法院設下門檻，亦不無平衡專利權人與社會大眾權益之用意<sup>215</sup>，而 Festo 魔咒亦將揮之不去。<sup>216</sup>

See Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co., 324 U.S. 806, 814 (1945). 此亦爲毒樹毒菓子理論之基礎，亦即專利之取得需具正當性與合法性，任何不正行爲應予以阻卻，且不正行爲下取得之權利，其行使亦會被阻卻。

<sup>209</sup> See “Redefining claim drafting and patent prosecution under Festo” by Martha M. Rumore, IPL Newsletter, Volume 22, Number 4, Summer 2004.

<sup>210</sup> 筆者往來之美國律師 Mr. John Chupa 於 2004 年 11 月時於台北當面告知筆者此策略。

<sup>211</sup> See “Losing Ground, The Extension of Festo in Honeywell v. Hamilton Sundstrand” by William M. Atkinson, Kirk T. Bradley, and Benjamin Pleune, IPL Newsletter, Volume 22, Number 4, Summer 2004.

<sup>212</sup> See “Redefining claim drafting and patent prosecution under Festo” by Matha M. Rumore, Id.

<sup>213</sup> 筆者曾與美國律師 Mr. John Chauncy Johnson 討論此案之發展，並曾撰文「均等論之末路悲歌」。

<sup>214</sup> 舉簡單例子而言，若原來申請專利範圍之一元件列述爲金屬，實施例爲銅，唯審查委員若引證銀並伴同其他元件，而爲顯而易知之核駁時，則申請人將金屬限縮爲銅之時，其實先前技藝之限，對熟習該項技藝人士而言，亦會推知到銅外，亦可推知到其他特定金屬材料，如金、鐵…等。

<sup>215</sup> “The doctrine of equivalents, when applied broadly, conflicts with the definitional and public-notice functions of the statutory claiming requirement.” See Warner-Jenkinson, 520 U.S. at 29.

<sup>216</sup> 實則最高法院於 Festo 案中之判決中之判決，於發回 CAFC 時亦引起不同之解讀，美國法界長期以來對最高法院判決之評語爲：「The supreme court is not supreme because it is always right; It is always right because it is supreme.」

<sup>206</sup> In this case the surrender is particularly clear. While Apotex was merely rewriting a dependent claim into independent form, the effect on the subject matter was substantial. The dependent claims that were redrafted into independent form did more than simply add an additional limitation; they further defined and circumscribed an existing limitation for the purpose of putting the claims in condition for allowance. See Ranbaxy Pharmaceuticals, Inc. v. Apotex, Inc., 350 F.3d 1235 (Fed. Cir. 2003).

<sup>207</sup> If acetic acid was readily known by chemists to be equivalent to formic acid, it would have been foreseeable to literally include acetic acid in the claim. Therefore, at this stage of the litigation, Apotex has not overcome the presumption that it has surrendered coverage of acetic acid.

<sup>208</sup> He who comes into equity must come with clean hands.”